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In The

Supreme Court of the United States

OCTOBER TERM, 1951

No. [redacted] 64

HAMLIN P. ANDRUS, LOUIS GELBMAN and
BESSER MANUFACTURING COMPANY,
Petitioners,
vs.
JOHN A. WHITMAN, MELVIN O. WENZEL and
HOWARD W. GOETSCH,
Respondents

PETITION FOR WRIT OF CERTIORARI AND BRIEF IN SUPPORT THEREOF

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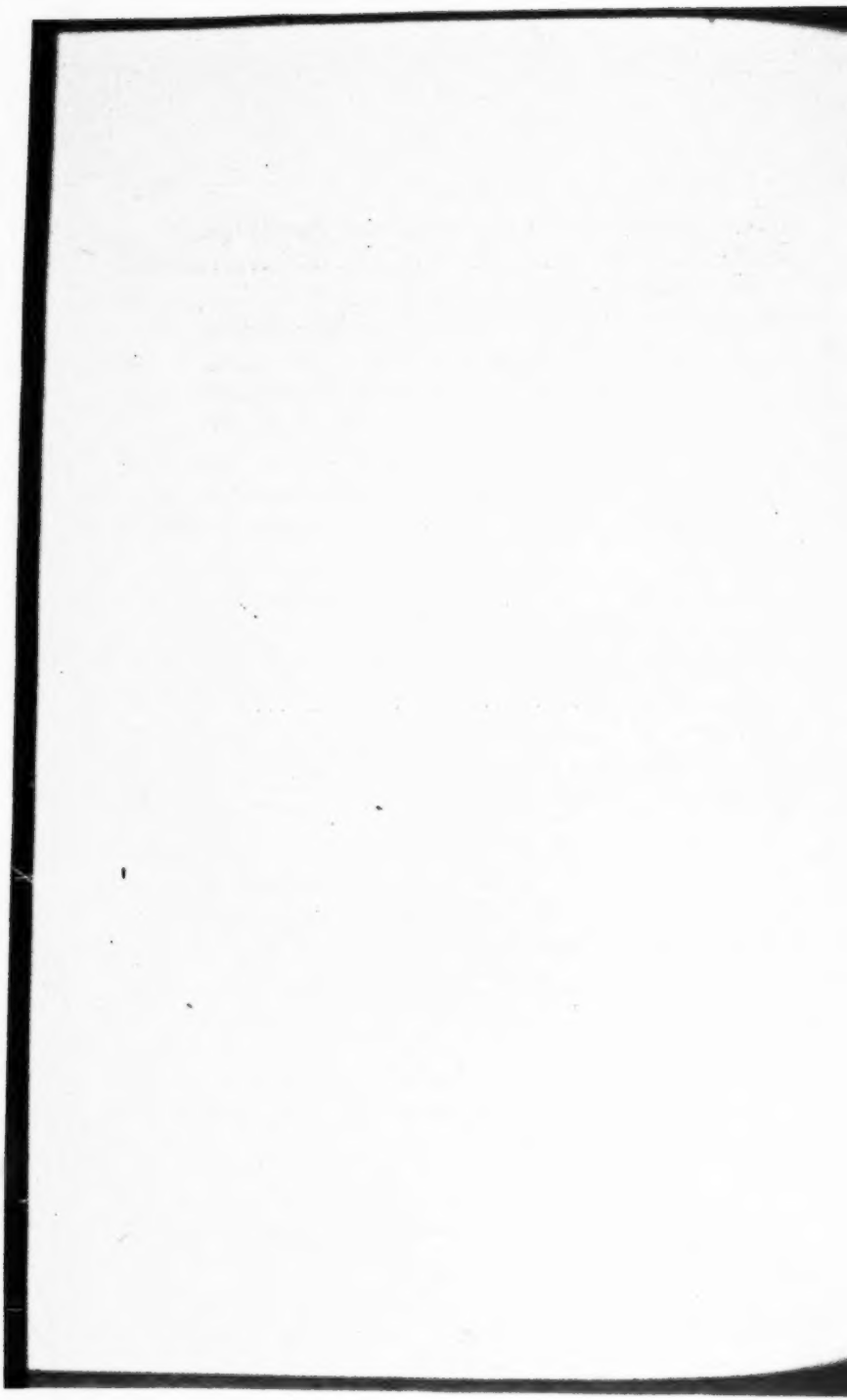

In The

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OCTOBER TERM, 1951

No.....

HAMLIN F. ANDRUS, LOUIS GELBMAN and BESSER MANUFACTURING COMPANY,
Petitioners,

vs.

JOHN A. WHITMAN, MELVIN O. WENZEL and HOWARD W. GOETSCH,
Respondents

PETITION FOR WRIT OF CERTIORARI AND BRIEF IN SUPPORT THEREOF

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioners, Hamlin F. Andrus, Louis Gelbman and Besser Manufacturing Company, respectively, pray that a writ of certiorari issue to review a judgment of the

United States Circuit Court of appeals for the Sixth Circuit entered February 19, 1952, in the above-entitled case.

Certified transcript of the record in the case including the proceedings in the Circuit Court of Appeals is furnished herewith in compliance with Rule 38 of this Court.

SUMMARY STATEMENT OF THE MATTER INVOLVED

Three patents in the art of concrete block manufacturing, viz., the Scott patent No. 2,106,329 (R. 25; Vol. II,[1] R. 352), the Gelbman apparatus patent No. 2,275,676 (R. 26; Vol. II, R. 353) and the Gelbman method patent No. 2,366,780 (R. 26; Vol. II, R. 354), were the subject matter of consolidated litigation in District and Appellate Courts in the Sixth Circuit, the decisions of which give rise to this petition.

These patents relate to a revolutonary advance, following thirty years of an inferior practice, in method and machinery for consolidating concrete block material in a mold as fully recognized in the following findings made by the District Court and the Sixth Circuit Court of Appeals:

"FINDINGS OF FACTS"

> "For over thirty years concrete blocks were made by pouring the usual dampened mix into a mold, then tamping the mix to compact it, adding more material, more tamping, etc., so that as many as five separate charging and tamping operations were required for the standard 8-inch block. This method was not only time consuming and costly, but produced a block that tended to have lines of cleavage formed between each added layer of material." (District Court, R. 323).

> "In the late thirties, there was a marked changeover to vibration to compact the block in the mold and the Besser Company changed from tamping to vibration • • • Besser employed the teachings of the Scott patent which was for a vibrating machine and the innovations of Gelbman incorporated in the

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[1] All references to the record are to Volume I unless otherwise indicated.

Gelbman application of 1937 long before the Gelbman patent issued. His introduction to effective vibration really came, he says, from Gelbman. Other machines using the vibration principle that had been brought out during this period or before had failed to come into general use because in them the whole machine vibrated rather than merely the mold. The use of vibration as taught by Gelbman doubled production and improved the result as compared with the tamping devices because they avoided the wear on the machine which the tampers produced and gave a more even texture to the block, since the concrete was put into the mold in mass rather than by steps between successive tamping impulses which left laminations in the block" (6 CCA, R. 356, 357).

The tamping machines referred to in the above-quoted fact findings were characterized by the use of a rigid support for the block mold in order to make the tamping blows effective. The Scott patent departed from the prior art rigid mold supports by teaching the use of resilient means interposed between the rigid supporting frame of the concrete block making machine and the concrete block mold whereby the mold is freed for vibration substantially independently of the frame, as set forth in claim 6 of the Scott patent, together with the use of a powerful high frequency orbital type of vibration imparted directly to the mold and to the concrete mix contained therein by means of an eccentrically weighted shaft (15) driven by a flexible belt (17) and rotatably mounted in bearings (16) bolted directly to one of the vertical sides of the mold (see Figs. 1 and 2, Scott patent); the resulting orbital vibration of the mold and its contents being of a character such as to prevent settling of the finer particles of the mix and effect such an interlocking of all the particles thereof that uniform packing

of a block 8 inches in height that will stand up and not slump upon ejection is achieved, a result never before produced by the prior art type of gravity jolting vibration machines.

As it is necessary to remove the molded concrete block from the mold for it to be usable, Scott also disclosed and claimed (Claim 6), as part of his fully and completely operative combination,—"means for removing the formed mass of material from the mold, said means including elements mounted upon the frame.";—such removal or ejecting means and elements thus being isolated from the mold's vibration by the resilient means interposed between the mold and the frame.

The Gelbman apparatus or machine patent likewise employed a resiliently mounted mold powerfully vibrated by a rapidly rotated eccentrically weighted shaft, but in conjunction with a reciprocating feed drawer 30 carrying a charge of material slightly in excess of the required amount and shuttling alternately from a position under a main supply hopper 26 to a position of full juxtaposition over the mold 34 to discharge the material into the mold and then back, such patent departing from the earlier practice of having the feed drawer ride on and in contact with the mold to minimize loss of material, and teaching instead the practice of eliminating contact between mold and feed drawer thereby eliminating the transmission of vibration from the mold to the feed drawer together with objectionable packing of material in the main supply hopper, excessive wear in the feed drawer and unwanted damping of mold vibration.

The Gelbman method patent, a division of the apparatus patent and hence containing the same disclosure, taught the practice of powerful vibration of an oversized mold

34 during engagement of the feed drawer 30 to pack material therein while the feed drawer remains superimposed over the mold thereby accurately filling it with a consistently uniform quantity of material from the excess in the feed drawer which is scraped off upon retraction, followed by the continued vibration of the mold during the application of a gravity actuated pressure head on the top of the material whereby a simultaneous smoothing of the top face of the block is achieved, together with a further consolidation of the block to a uniform density and to a uniform depth below the top surface of the mold. The means disclosed in the drawings (See Figs. 10 and 18) and described in the specification for vibrating the mold comprise a poly-phase squirrel cage motor 59 (having a characteristic speed in the order of 3500 r. p. m. in the case of a two pole field) directly coupled to a rotatable shaft 54 carrying two off-center weights 57, the size of which is generally indicated in the drawings, together with rods 67 for imparting to the mold vibrations which are induced in the shaft by the off-center weights and adjustable stops 64 for limiting the amplitude of vibration, no exact motor power or dimensional range of adjustment of amplitude being mentioned.

Of the six general issues of validity and infringement litigated, the appellate court expressly agreed with the lower court on only one. Thus, the District Court held the Gelbman apparatus patent valid and infringed (R. 332), the Gelbman method patent not infringed (R. 336), and initially held the Scott patent invalid and not infringed (R. 329), the latter and only holding of invalidity being withdrawn on rehearing (R. 340); while the Court of Appeals held all three patents invalid (R. 360, 364, 365) and expressly affirmed only the lower Court's holding of non-infringement of the Gelbman method patent (R. 360-362).

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In reversing the District Court's holding of validity of the Gelbman **machine** patent, the Court of Appeals based its holding of invalidity primarily on an unprecedented ruling that invention in the concept of a new and functionally improved relationship between elements of a machine cannot support patentability in the absence of separate and distinct invention in the particular means *per se* employed in materializing such inventive concept. Such ruling is stated in the following language of the appellate court's opinion.

> "This leads us to a consideration of the relationship between a new concept and the means or instrumentalities by which the new idea may be put into practice (R. 358).
>
> • • • • •
>
> "Assuming, but not deciding, that there was inventive thought in the concept of keeping the feed drawer from touching the mold so as to prevent the transmission of vibration to it from the mold, the concept itself was not patentable unless it became materialized by means themselves new and not within the expected skill of the art" (R. 359).

Relative to the Gelbman **method** patent, the Court of Appeals found no lack of invention upon which to base its holding of invalidity but suprisingly resorted, entirely on its own initiative, to the technical grounds of insufficient disclosure of the vibrating apparatus. No issue, evidence or argument had been directed to this question or in any way raised before either court. The essence of the claimed patented method clearly relates to a particular sequence of steps during which effective vibration, in itself previously known to the art in compacting concrete blocks, is applied to a concrete block mold to assist in

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> "As the feed drawer advances, or during a portion of the time that it advances, or *after it has reached its position over the mold,* depending merely on the adjustment of the machine, the vibrator will be operating" (p. 7, col. 1, l. 7-11).

Such construction of the limitation "vibrating the mold during engagement of said feed drawer" was made without giving any distinction or effect to the narrower language of Claim 1[3] calling for "moving a feed drawer with plastic material across a *vibrating* mold."

The Court of Appeals also resorted to a mere suppositious file wrapper argument in construing the term "yielding pressure head" in claim 2 as excluding defendants' equivalent gravity actuated and therefor yielding tamping pressure head.

In holding Claim 6[4] of the Scott patent invalid (R. 365), the Court of Appeals relied upon a file wrapper reference patent to Taylor (R. 228; Vol. II, R. 377) in the art of washing and separating ore disclosing a vibrated sieve and held such patent to be in an "analogous art," notwithstanding the specific limitations of claim 6, "In apparatus for the molding of plastic materials like concrete." the use of the

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[3] "1. A method for making a building block, consisting in moving a feed drawer with plastic material across a vibrating mold by starting on one side of the mold and moving the said drawer until it is superimposed on the mold to fill and pack the mold, quickly moving said feed drawer off the mold to strip excess plastic material from the mold, and quickly applying a pressure head upon the top of the material in the mold during continued vibration of said mold."

[4] "6. In apparatus for the molding of plastic materials like concrete, a mold for receiving the material, a supporting frame, a resilient means interposed between the mold and the frame whereby the mold can be vibrated substantially independently of the frame, means for applying vibration to the mold, and means for removing the formed mass of material from the mold, said last means including elements mounted upon the frame."

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term "mold" throughout the claim, and the further limitation "means for removing the *formed mass of molded* material from the *mold.*" The Court's opinion ignored such claim limitations restrictive to the art of concrete block molding as well as the diametrically opposite end result of washing and separating ore by settling out the finer particles through a sieve as compared to consolidating and compacting concrete in a mold with a vibration expressly stated in the specification to **prevent** settling and separation. The Court relied instead on the indefinite title of the Scott patent "Apparatus for Treating Materials" and the double meaning of the word "concentrating" as applicable to the diametrically opposite concepts of **separating** in the case of ore and **compacting** in the case of concrete blocks (R. 365). Basing its holding of anticipation of the main subject matter on the obviously nonanalogous ore washing and separating patent, which issued some thirty years before the Scott patent, the Court of Appeals found the individual elements of Claim 6, including the ejecting means, old and their joinder a noninventive aggregation.

While the lower Court's holdings of noninfringement of the Scott and Gelbman method patents formed the sole issues in plaintiffs' appeal relative to both patents, the opinion in the Court of Appeals, although affirming noninfringement of the Gelbman method as coordinate grounds for dismissal, is completely silent on such issue relative to Scott. Thus the District Court's decision of noninfringement of claim 6, based on the implied importation of express limitations of other claims into Claim 6 (R. 326, 327), while not expressly affirmed, stands without correction.

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JURISDICTION

1. This petition involves suits arising under the patent laws of the United States R. S. Sec. 4921 (35 U. S. C. §70).

2. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925 and June 25, 1948 (28 U. S. C. §1254).

3. The date of the judgment which petitioners seek to have reviewed is February 19, 1952, Petition for Rehearing denied March 20, 1952.

4. Among the cases which support granting of certiorari in the absence of directly conflicting decisions involving the same patents are the following wherein:

a. Litigation in other circuits was unlikely and the nature of the questions presented was such as to render review desirable;

b. Questions of public importance were involved;

c. Alleged conflicts were involved with other decisions involving similar issues in the same or other circuits and with principles established in Supreme Court decisions; and

d. Where an issue involving the correct criteria of patentable invention was involved.

Exhibit Supply Co. v. Ace Patents Corp., 315 U. S. 126;
Muncie Gear Works v. Outboard, M. & Mfg. Co., 315 U. S. 759;
Morton Salt Co. v. G. S. Suppiger Co., 314 U. S. 488;
Lincoln Engineering v. Stewart-Warner Corp., 303 U. S. 545;
Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corporation, 340 U. S. 147.

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QUESTIONS PRESENTED

1. Whether, assuming that there was inventive thought in the concept of a new and improved relationship between elements of a patented machine, separate and distinct invention must also be found in the particular means *per se* for materializing such inventive concept in order to avoid invalidity for lack of invention.

2. Whether a **method** patent is rendered invalid for failure to disclose a complete operational method by omission of **quantitative** details of collateral **apparatus** known to the art for the purpose disclosed and fully described in complete **qualitative** detail in both the patent drawings and specifications.

3. Whether an indefinite title of a patent may or should supplant specific claim language and the express purposes described in the specification to render analogous and anticipatory a reference patent disclosing an apparatus used in a clearly nonanalogous art for accomplishing a diametrically opposite end result.

4. Whether distinctions in the express limitations of different claims of a patent should not be given effect in interpreting the scope of such claims.

   a. Where the specification of the patent clearly comprehends alternative operations conforming with distinctions in limitations of different claims; and

   b. Where noninfringement may be established only by importing implied limitations into the claim in suit which comprise express limitations of other claims of the patent.

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5. Whether a mere file wrapper argument limits a claim in the absence of any cancellation, amendment, reliance by the Patent Office or other recognized ground for establishing a file wrapper estoppel.

6. Whether a revolutionary advance in the art of manufacturing a basic commodity, following a period of over thirty years' use of an inferior practice, should not require substance to take precedence over formalism to the end that patents of professional inventors, recognized by foremost manufacturers as covering vital contributions to such advance, shall be upheld and thus promote industrial progress within the intent of the Constitution rather than stricken down on purely technical grounds such as to discourage future inventive development.

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REASONS RELIED UPON FOR ALLOWANCE OF THE WRIT

All of the questions presented relate to matters of great public importance concerning the interpretation and application of our patent laws, within the purview of Supreme Court Rule 38, Section 5b.

1. The decision of the Sixth Circuit Court of Appeals in holding that an inventive concept relating to a new and improved relationship between elements of a machine cannot satisfy the requirement for invention to support the patentability of a machine claim, but that separate and distinct invention must be found in the particular means *per se* for embodying such inventive concept, enunciated an unprecedented legal principle that threatens the entire statutory class of machine inventions and decided a question of great public importance in conflict with its own decision in *Lakewood Engineering Co. v. Walker et al.*, 23 Fed. 2d 623; with the Second Circuit in *Gillman v. Stearn*, 114 Fed. 2d 29; and in conflict with established principles of patentable invention laid down and consistently followed in the decisions of this court in *C. & A. Potts & Co. v. Creager*, 155 U. S. 597; *National Cash Register Co. v. Boston Cash Indicator & Recorder Co.*, 156 U. S. 502; *Hobbs v. Beach*, 180 U. S. 383 and *Jungersen v. Ostby & Barton Co.*, 335 U. S. 560.

2. The Sixth Circuit Court of Appeals in holding the Gelbman method patent invalid for failure to disclose a complete operational method and in basing such holding on testimony as to experimentation by a licensee relating to quantitative aspects of known collateral apparatus to obtain "results desired," enunciated an unprecedented requirement for disclosure of details collateral to the essen-

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tial invention and decided a question of great public importance in conflict with thoroughly established and generally recognized authorities relating to sufficiency of disclosure, viz., that the description of an art or process is sufficient if it enables persons skilled in the art to use it without making experiments or changes involving invention as distinguished from experiments required to produce the best result; and that the patentee need not describe in detail what was already known to the art but may begin at the point where his invention begins and describe what he has made that is new and what it replaces of the old, *69 Corpus Juris Secundum,* §104, b, (2) pp. 432-434; *Walker on Patents,* Deller's Ed., §163, pp. 743-749; *Anderson v. Walsh,* 152 Fed. 2d 975, (C.C. & P.A.)); and in conflict with the opinions of this Court in *Webster Loom Co. v. Higgens et al.,* 105 U. S. 580; *Carnegie Steel Co. v. Cambria Iron Co.,* 185 U. S. 403; *Expanded Metal Co. v. Bradford,* 214 U. S. 366; *Eibel Process Co. v. Minn. & Ontario Paper Co.,* 261 U. S. 45; and *Powers v. Concrete Mixing and Conveying Co.,* 282 U. S. 175.

3. The Sixth Circuit Court of Appeals in holding in effect that a broad and indefinite title of a patent in suit may supplant specific limitations of a claim thereof and the definite purpose set forth in the specification so as to render analogous and anticipatory a patent disclosing an apparatus used in a clearly nonanalogous art for accomplishing a diametrically opposite end result, resorted to formalism at the expense of substance and decided a question of great public importance in conflict with its own prior decisions in *Egry Register Co. v. Standard Register Co.,* 267 F. 186 and in *General Metals Powder Co. v. S. K. Wellman Co., et al.,* 157 Fed. 2nd 505, and in conflict with the decisions of this Court in *Potts v. Creager,* 155 U. S. 597 and *National Cash Register Co. v. Boston Cash Indicator and Recorder Co.,* 156 U. S. 502.

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4. As to the important question of effect to be given distinctions in the limitations of different claims in distinguishing the scope of such claims, the decision of the Sixth Circuit Court of Appeals in construing Claim 2 of the Gelbman method patent as if limited by the narrower language of Claim 1, and the decision of the District Court in holding Claim 6 of the Scott patent not infringed by importing express limitations of other claims into claim 6, decided a question of great public importance in direct conflict with the established law enunciated in its own prior decision in *Chamberlin Metal Weather Strip Co. v. Barringer*, 105 Fed. 2d 880, and in conflict with the decision of this Court in *T. H. Symington Co. v. National Malleable Castings Co., et al.*, 250 U. S. 383, and *Smith v. Snow*, 294 U. S. 1 holding that specific limitations of other claims cannot be read into the claim in suit.

5. The decision of the Sixth Circuit Court of Appeals in relying upon a suppositious file wrapper argument relating to distinctions over prior art and thereby imposing an unnatural limitation upon the construction of Claim 2, conflicts not only with the record evidence concerning such argument, but with the law enunciated by decisions in other circuits as well as the Sixth Circuit and by this Court that mere file wrapper arguments do not enlarge, diminish or vary the language of a patent afterwards issued, *Auto Pneumatic Action Co. v. Kindler and Collins*, 247 F. 323 (C. C. A. 2); *Lektophone Corp. v. Rola*, 34 F. 2d 764 (C. C. A. 9); *Firestone Rubber Co. v. United States Rubber Co.*, 79 F. 2d 948 (C. C. A. 6); *Goodyear Dental Vulcanite Co. v. Davis*, 102 U. S. 222.

6. The narrow, strict and formalistic approach reflected in the decision of the Sixth Circuit Court of Appeals is not consonant with a sound construction based on substance,

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particularly due the present patents relating to a pioneer advance in a basic industry, and is in conflict on a question of public importance with the decisions of this Court in *Smith v. Snow*, 294 U. S. 1; *Eibel Process Co. v. Minn. & Ontario Paper Co.*, 261 U. S. 45; and *Morley Sewing Machine Co. v. Lancaster*, 129 U. S. 263.

7. Since, as a result of the decision of *United States v. Besser Mfg. Co., et al.*, 96 F. S. 304 as subsequently amended, it is unlikely that suits will be brought on the same patents in other circuits which might give rise to directly conflicting decisions on the same matter, and since the questions presented are believed to be of such public importance as to render review desirable, this is a proper case for granting certiorari. *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126; *Muncie Gear Works v. Outboard M. & Mfg. Co.*, 315 U. S. 759.

Wherefore it is submitted that this petition for a writ of certiorari to review the judgment of the Court of Appeals should be granted.

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BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

OPINIONS BELOW

The opinion of the Circuit Court of Appeals below is reported at 194 F. 2d 270.

The opinion of the District Court including the opinion on rehearing is reported at 93 F. S. 383.

GROUNDS ON WHICH JURISDICTION IS INVOKED

The date of the judgment to be reviewed and other details justifying jurisdiction are set forth at page 12 of the accompanying petition.

STATEMENT OF THE CASE

Petitioners, Hamlin F. Andrus and Louis Gelbman, as owners by mesne assignments of the Gelbman et al. patents Nos. 2,275,676 for Concrete Block Machine and 2,366,780 for Method of Making Building Blocks brought patent infringement actions in the Northern Division of the Eastern District Court of the United States, State of Michigan, against defendant John A. Whitman of Midland, Michigan, and defendants, Melvin O. Wenzel and Howard W. Goetsch, of Rogers City, Michigan, alleging infringement of claims 1 to 4 of the machine patent and claims 1 and 2 of the method patent in the use of intervening defendant Lith-I-Bar Company's "Lith-I-Block" machine.

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The complaints in both cases, Civil Action Nos. 749 and 750 respectively, were filed on August 24, 1949 (R. 2, 12). On September 29, 1949, answers were filed on behalf of both the defendant John A. Whitman and the defendants Melvin O. Wenzel and Howard W. Goetsch (R. 3, 13).

On November 10, 1949, the Besser Manufacturing Company, a corporation of Michigan, owner by mesne assignments of the Scott Patent No. 2,106,329 brought its complaint against said defendant John A. Whitman in Civil Action No. 763 charging infringement of claims 1 and 6 of said Scott patent by the use of said Lith-I-Block machine (R. 15). On November 16, 1949, defendant Whitman filed his answer (R. 16).

The answers relative to all three patents denied infringement and asserted invalidity citing a large number of prior patents (R. 8, 9, 10, 12, 17). By stipulation of the parties, the Besser suit 763 was consolidated for trial with suits 749 and 750 (R. 22). The trial of the above cases was started on January 3, 1950, before Judge Picard at Bay City, Michigan and the trial was completed on January 6, 1950.

On June 28, 1950, the opinion of the District Court was filed (R. 322) holding claims 1 to 4 of the Gelbman machine patent valid and infringed, claims 1 and 2 of the Gelbman method patent not infringed and claims 1 and 6 of the Scott patent invalid and not infringed. Application by defendants for rehearing on the holding of validity and infringement of the Gelbman machine patent was denied by order filed July 12, 1950 (R. 341). Plaintiffs applied for rehearing on the holding of non-infringement of the Gelbman method patent and invalidity and non-infringement of the Scott patent which was granted and an opinion of the Court

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upon rehearing was filed on October 10, 1950, modifying its decision by the withdrawal of the holding of invalidity of the Scott patent, expressly retaining the holding of non-infringement of the Scott patent as well as other portions of the opinion relative to issues raised at the rehearing [non-infringement of the Gelbman method patent] (R. 340). A decree of the Court was filed on November 6, 1950 ordering recovery of damages and authorizing an injunction relative to infringement of the Gelbman machine patent and dismissing that portion of the suits based on the Gelbman method and Scott patents (R. 339).

Notices of appeal to the Sixth Circuit Court of Appeals were filed by both parties on December 6, 1950, relative to the respective adverse holdings (R. 341-343). A stipulation re physical exhibits and joint designation of record was filed on January 18, 1951 (R. 345, 346). The separate appeals 11,364, 11,365 and 11,366, were heard under one record and as a single case on December 11, 1951, and a decision was entered on February 19, 1952 holding all three patents invalid, the Gelbman method patent not infringed and being silent on the issue of Scott infringement (R. 355). Petition for rehearing was filed by plaintiffs on March 10, 1952 (R. 367). A reply thereto was filed by defendants on March 13, 1952 (R. 379). An order denying petition for rehearing was filed on March 20, 1952 (R. 385).

The main issues raised by the Court of Appeals' decision and the Petition for Certiorari are discussed briefly in the summary statement of the matter involved in the foregoing petition. The following includes a further statement of all that is material to the consideration of the questions presented under headings of the respective patents involved:

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Gelbman Apparatus Patent

In so far as the issues presented by this petition are concerned the subject matter of the Gelbman machine patent (R. 26; Vol. II, R. 353) may be sufficiently understood by a reading of claim 3 which we quote below separated in its elements:

"In a building block machine,

(1.) a frame for the block machine,

(2.) a mold for making concrete or the like blocks,

(3.) means for vibrating or jolting said mold to pack the concrete material therein during making of said blocks,

(4.) a supply hopper for a large mass of concrete material,

(5.) a feed drawer working between said hopper and mold to supply the mold with concrete material as needed,

(6.) a track system mounted on said frame for the feed drawer to ride on and holding the feed drawer from touching the mold preventing the transmission of vibrations from the mold to the feed drawer,

(7.) a plate mounted on said feed drawer and extending across the bottom of said hopper when the feed drawer moves to its position over said mold."

This claim is typical of the first three claims and more typical of the combination involved than claim 4, printed in the Court of Appeals opinion, since claim 4 omits reference to the main supply hopper (Element 4 above). The main object of isolating mold vibration from the feed

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drawer and the relation thereto of the main supply hopper is clearly stated in the patent specification:

> "This is an advantageous construction, for should the vibrations be transmitted, the feed drawer cut off plate 35 [Element 7] would vibrate and would vibrate the concrete material in the chute 26. [supply hopper]. This will cause packing of the concrete in the chute, which is objectionable." (Vol. II, R. 353, p. 3, col. 1, lines 3 to 9).

The elimination of transmission of mold vibration to the feed drawer also accomplished two additional marked advantages, viz., a substantial reduction in the wear between adjacent parts of the mold and feed drawer by eliminating metal-to-metal contact therebetween and the elimination of damping of mold vibration by the feed drawer incident to metal-to-metal contact between adjacent parts thereof (R. 39, 40).

Over nine years elapsed between the closest reference Dahl and the Gelbman patent applications. Dahl, Shinn, Thomas and Gelbman all dealt with vibrating molds and overriding feed drawers or supply hoppers for a period exceeding nine years before the Gelbman invention in question isolated mold vibration from such supply means. No one else was shown to have come independently upon the desired solution before it was publicly disclosed by Gelbman. Besser Manufacturing Co. and Stearns Manufacturing Co., the largest manufacturers of concrete block making machines in the country are licensees under the present Gelbman patent and unquestionably employ the invention in all of their vibratory machine output (R. 39, 40, 48, 49, Vol. II —360).

On appeal the sole question raised by defendants as to the District Court's holding of infringement related to

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the purely fact issue of whether in defendants' machine as used in actual operation, the feed drawer was in contact with the mold or out of contact and thereby isolated from mold vibration in accordance with the patent claim. Since there is no occasion for this Court to review this question of fact, the record evidence will not be discussed other than to refer to the pages of the record at which petinent testimony may be found clearly establishing the absence of contact and absence of vibration transmission in defendants' machine (R. 63, 64, 73, 149, 150, 156).

Defendants' appeal from the lower Court's holding of validity of the Gelbman machine patent was likewise grounded on the fact issue of whether either the Thomas patent (a file wrapper reference, R. 193, Def. Ex. I) or the Shinn patent (R. 208; Vol. II, R. 375), disclosed a construction in which solid metal-to-metal vibration transmitting engagement between the mold and feed hopper is prevented and hence which would anticipate the Gelbman apparatus feature of isolating mold vibration from the feed drawer and thereby prevent objectionable packing of the concrete aggregate in the main supply hopper. Since the District Court found no teaching of elimination of vibration transmitting contact in these prior art patents (R. 331) and the Court of Appeals concurred in the lack of anticipation of this feature (R. 358) we again have concurring opinions on a fact issue which this Court will have no occasion to review so here too we will refer merely to the pages of record evidence clearly establishing that neither Shinn or Thomas taught a construction for preventing mold vibration transmitting contact with the feed drawer [Physical Exhibit H, p. 189 (file wrapper of Gelbman machine patent), R. 193, 216, 234, 249-253]. Thus, the only issue raised by this petition relative to the Gelbman machine patent is

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the legal issue relating to error in the Court of Appeals' holding that invention in concept will not support patentability in the absence of further invention in the means *per se* for embodying the inventive concept.

Gelbman Method Patent

Plaintiffs' appeal below was limited to the District Court's holding of non-infringement of claim 2 of the Gelbman method patent (R. 333-336), affirmed by the Court of Appeals (R. 360-362).

In so far as the issues of this petition are concerned, the Gelbman method may be understood from a careful reading of claim 2 as quoted below separated in its main divisions for convenient reference.

> "2. A method for making a building block, consisting in
>
> (1.) moving a feed drawer with plastic material across a mold by starting on one side of the mold and moving the said drawer until it is superimposed on the mold, vibrating the mold during engagement of said feed drawer to pack said material therein,
>
> (2.) moving said feed drawer off the mold during continued vibration thereof, and continuing the vibration of said mold and engaging a yielding pressure head on the material in the mold during said latter vibration period."

The pertinent description in the patent specification (Vol. II, R. 354) concerning this method is set forth below:

> "As the feed drawer advances, or during a portion of the time that it advances, or after it has reached its position over the mold, depending

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merely on the adjustment of the machine, the vibrator will be operating. (p. 7, Col. 1, lines 7-11)

• • •

"Concrete or the like material from the chute 26 which was deposited in the feed drawer was thus moved over the mold and packed into the mold by the vibrations of the mold. (p. 7, Col. 1, lines 16 to 19.)

• • • • •

"An important feature of the machine must now be clearly understood. When the feed drawer moves back to its original position it struck off all excess material from the top of the mold. A quantity of material to make a commercially desirable block was now left in the mold, but the top of this block was not packed sufficiently. The mold is so designed that it is higher than the required height of the block. Now when the pressure head falls down and vibrations continue, the top of the block will be packed and smoothed out and thus completed. This is a very important feature of the operation of the machine. P. 7, col. 1, lines 44-56.

• • • • •

"When the pressure head is resting on the concrete material in the mold it will progressively descend as the concrete becomes packed. P. 7, col. 1, lines 72-75.

• • • • •

"the pressure head sinks a predetermined amount into the mold and so forms blocks of universal height." P. 7, col. 2, lines 16-18.

Defendants unquestionably and admittedly practice this method in the use of their machines subject to only two

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alleged distinctions which were held by the courts below to avoid infringement.

1. Relative to the first step, defendants' mold vibration is not operating as the feed drawer advances or during a portion of the time that it advances but rather starts to operate when the feed drawer has reached its position over the mold (R. 361).

2. Relative to the second step, defendants do not use a pressure head which falls once and then rests on the material but rather use a gravity actuated pressure head which either tamps (as in the Midland machine), or partially tamps and partially rests (as in the Rogers City machine), on the material in the mold during the latter vibration period (R. 335, 336).

There is no dispute concerning the facts above stated as to the operation of defendants' machine and the sole question raised by this petition relative to infringement of the Gelbman method patent relates to the legal construction of claim 2 held by the District and Appellate Courts to exclude defendants' operation, although the alleged distinctions were not supported or imposed by limitations in the language of claim 2, nor by the specification of the patent, nor by reason of any file wrapper estoppel, nor by any prior art.

The Court of Appeals initiated a holding of invalidity of the Gelbman method patent on the grounds of its "failure to fully disclose a complete operational method" (R. 364). This holding was based on testimony of the witness Besser relating to experimentation with vibrating apparatus in trying out

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> "various speeds of the vibrating member, and the various amounts of weights to give various vibrating forces, [and] various sizes of motors to give the results desired" (R. 31),

together with a supposed deficiency of disclosure of vibrating apparatus in the patent suggested for the first time in the opinion of the appellate court below:

> "There is no mention in the specification of the vibrating force required or its amplitude nor do the drawings in any way assist us" (R. 363).

With no record evidence to support any expanded inference, the Court of Appeals seized upon the above quoted Besser testimony and amplified it to mean that Besser

> "could not make a successful block without organizing a new machine, incorporating elements of both Gelbman and Scott and undertaking extensive experiments of his own before it could be constructed to successfully function" (R. 363).

and that

> "Besser's experimentation was basic to a useful method and imperative to disclose, even to those skilled in the art, the successful functioning of the patented method" (R. 364).

These conclusions were arrived at independently by the Court of Appeals without benefit of evidence directed to the point, argument of counsel, or consideration by the court below, and are in fact contradicted by other record evidence as will be pointed out in the argument.

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The Scott Patent

As found by the District Court:

> "The Scott apparatus patent was granted January 25, 1938 on an application filed almost eleven years before. Its claimed invention lies in the fact that it describes a form or mold holding the mix freed from the rest of the machine during vibration by incorporating resilient supports between the mold and frame of the machine, imparting a high frequency orbital form of vibration to the mold, and producing and concentrating such vibration in the mold by the direct bearing attachment of a high speed eccentrically weighed orbital vibration producing shaft on a remote flexible drive. It also includes an ejection mechanism mounted on the frame of the machine but the machine is so constructed that the mold remains perfectly free to vibrate and the concrete block is ejected after the consolidation thereof is completed" (R. 324, 325).

As fully recognized by both District and Appellate Courts, a revolutionary advance in the concrete block making industry came about with the adoption of the Scott-Gelbman type of vibration for compacting the concrete mix in the mold (R. 323, 356). The contribution of the Scott invention to this revolutionary advance consisted in teaching a construction wherein a powerful vibrating mechanism was attached directly to the mold, which was in turn isolated for vibration substantially independent of the frame by interposing resilient members between the mold and the frame, as well as in teaching the mounting of additional equipment such as ejecting mechanism on the frame so that it might in turn be isolated from mold vibration while being immediately available as an

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integral part of the machine for carrying out the essential operation of removing the molded and formed concrete block from the mold. Such isolation of mold vibration accomplished several marked advantages. It made possible highly effective packing vibration as it was confined to the mold. It avoided destroying the rest of the machine by the intense vibration required for effective packing (Besser R. 33, Brush R. 80, 82). No machine ever came into commercial use which attempted to vibrate the whole machine (R. 33). It also permitted a high frequency powerful intense orbital undirectional vibration of the mold (R. 40) which causes the particles of concrete to roll on one another (R. 82) so that the concrete becomes fluid and runs into the mold like water (R. 47). At stated in the Scott patent:

> "The vibration is such as to slide and roll the ingredients of the mixture on and against one another and force and pound them against the sides of the mold so that they are thoroughly intermixed and united. Furthermore by reason of the fact that settling is largely prohibited by the character of the vibration the resulting product has great uniformity" (Vol. II, R. 352, p. 2, Col. 2, lines 1-8).

The resultant concentration of this high frequency orbital undirectional vibration in the mold made it possible for the first time to compact an 8-inch block from a single charge not only free of laminations but capable of retaining its shape upon immediate ejection (Vol. II, R. 352, p. 2, col. 2, lines 54-66), a clearly unforeseeable result.

The witness Besser, a man foremost in the concrete black industry with over forty-five years of practical experience in the concrete block making machine art, testified that as a result of the shift over from the old tamping method to the Gelbman method and high frequency orbital Scott

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type vibration "It just about doubled the production" (R. 32). It resulted in "a better texture block, a more uniform block throughout because the material was put in in a mass instead of in steps by the tamper" (R. 34).

There was no contradiction of this testimony nor was any attempt made to deny the advantages achieved by the Scott invention as particularly pointed out in the Scott patent and as discussed by the witness Brush (R. 75-83).

Since the District Court withdrew its holding of invalidity, plaintiffs' appeal relative to Scott was directed solely to the District Court's holding of non-infringement of claim 6. The District Court's opinion in support of such holding (R. 326, 327) ignores the fact that defendants' machines fall clearly within the terms of the claim. While the opinion recites differences between the specific embodiments disclosed in the Scott specification and the specific construction of defendants' machine, such differences fall entirely outside of the terminology of claim 6 and moreover are included as express limitations in other claims of the patent by which such other claims differ from claim 6.

The opinion of the District Court did not attempt to point to any prior art or to any other basis for impressing unwritten limitations on the literal terminology of Claim 6 nor for requiring, in effect, a specific compliance with the particular embodiment of the patent disclosure, nor for its entire departure from a semantic interpretation of the claim language which reads squarely on the accused machines.

The Court of Appeals apparently did not agree with the District Court's holding of non-infringement as it did not adopt such holding as a coordinate grounds for affirming dismissal, as in the case of the Gelbman method patent, but instead affirmed the lower Court's dismissal on Scott solely on a holding of invalidity (R. 364, 365).

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The Court of Appeal's grounds for holding Scott invalid is stated in the following excerpts from the Court's opinion:

> "The uniting of vibration and ejecting means in a unitary structure was but an aggregation, each performing an old function in substantially the same old way [cases cited] (R. 365).
>
> "In any event, we find nothing new or disclosing inventive thought over prior art in Scott. Means for vibrating the mold were old. There was nothing new in a resilient mounting. Such mounting was explained by Taylor patent No. 899,441, granted September 22, 1908. [Vol. II, R. 377]. The challenge to Taylor on the ground that it was a patent in a non-analogous art must be rejected. While Taylor described his patent as an apparatus for concentrating materials and was directed to the concentrating of finely divided ores, coal or minerals in general, so was Scott. He entitled his patent as 'an apparatus for treating materials.' While he illustrated it by treatment of concrete, he described it as applying to all building materials" (R. 365).

It was conceded by defendants on appeal and is apparently the position of the Court of Appeals that in the absence of Taylor there would be no anticipation for Scott's resilient mold mounting which, as defined in the first portion of claim 6, would in itself constitute inventive and patentable subject matter. Thus, the ruling of non-invention hinges upon the correctness of the Court's holding as to Taylor being in an analogous art as does the Court's holding of aggregation, which depends upon a combination of old elements each performing an old function in substantially the same old way and which cannot stand if one of the elements is in itself new and inventive.

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SPECIFICATION OF ERRORS

The errors which petitioners will urge if the Writ of Certiorari is allowed are that the Court of Appeals below erred:

1. In holding that invention to support a machine patent must reside in the particular means *per se* employed to materialize a concept for a new and improved relationship between machine elements, as distinct from invention in the concept of such relationship;

2. In adopting an erroneous standard for sufficiency of disclosure of a patented **method** such as to require not only a complete **qualitative** disclosure but a detailed **quantitative** disclosure of collateral **apparatus** already known to the art for the purpose employed in carrying out the method, and in connection therewith

a. Making the erroneous finding:

> "There is no mention in the specification of the vibrating force required or its amplitude nor do the drawings in any way assist us" (R. 363).

which is directly refuted by an exhaustive discussion of such matters in the patent,

b. Failing to recognize that there was no evidence that any experimentation was necessary to obtain an **operative** or a **successful** result.

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c. Failing to distinguish between experimentation of an inventive nature necessary to obtain an operative result and experimentation of a non-inventive nature to obtain best or desired results,

d. Failing to follow the established rule that an exact and detailed disclosure need not be included as to subject matter known to the art,

e. Failing to recognize the full and detailed qualitative disclosure in both drawings and specifications as a sufficient description of suggested apparatus for use in a method invention,

f. Concluding that the machine disclosed in the patent for use in carrying out the patented method had not received commercial embodiment and could not be employed to make a successful block, in direct contradiction to the record evidence,

g. Misconstruing testimony of experimentation by a licensee to obtain "results desired" with apparatus of another earlier patent as having relevance and pertinence to the sufficiency of disclosure of equivalent apparatus in the method patent, and

h. Failing to recognize that the detailed apparatus of the method patent disclosure had been successfully used by another licensee with respect to which use no evidence of experimentation of any kind was in the record nor in any way suggested thereby;

3. In adopting erroneous criteria of analogous art so as to include a patent in an art obviously remote by any logical substantive standard and having a diametrically opposite end purpose from that of the patent in suit and in connection therewith

a. Ignoring the limitations of the claim in suit directed to "apparatus for the molding of plastic materials like concrete," to "a mold" and to "removing the formed mass of material from the mold,"

b. Ignoring the specification of the patent in suit expressly setting forth the purpose of preventing settling of smaller particles and promoting a uniform mixture of compacted material, and

c. Resorting to the indefinite titles "Apparatus for Concentrating and Washing Minerals" and "Apparatus for Treating Materials" and an abuse of divergent meanings of the word "concentrating" for finding analogy in the diametrically opposite end purpose of washing and **separating** fine and coarse particles of ore having no conceivable analogy to the art of **compacting** concrete blocks;

4. In failing to give effect to the distinctions in the limitations of different claims of a patent in distinguishing the scope of such claims;

5. In giving mere file wrapper argument erroneous construction and estoppel effect; and

6. In resorting to formalistic technical grounds to strike down patent rights relating to a revolutionary advance in the art of manufacturing a basic commodity calling for a substantive and liberal approach toward the enforcement of such rights.

ARGUMENT

This case presents vital questions of far-reaching public importance in the construction and application of our patent laws and particularly relating to rulings drastically departing from recognized standards of patentable invention, sufficiency of disclosure, analogous art and claim construction. These rulings, if not corrected, would stand as a threat to the entire statutory class of machine patents; as authority for attacking every patented invention utilizing known power equipment wherein quantitative data such as motor horsepower is not specified; as authority for virtually eliminating the concept of non-analogous art; and as authority for incorporating all arguments and statements of the entire file wrapper proceedings as a part of the issued patent for purposes of modifying the claim language.

It is believed that the questions presented and the reasons for granting the writ as set forth in the foregoing petition sufficiently summarize the argument which will therefor proceed directly to a discussion of the specific points involved.

POINT I

That an inventive concept of a new and improved relationship between elements of a machine may support patentability without separate and distinct invention in the particular means per se employed for materializing such inventive concept.

In ruling to the contrary the Court of Appeals relied on prior decisions holding that an inventive **method** concept, patentable as a method, cannot support the patentability of claims to non-inventive **apparatus** for carrying such method into practice. These decisions merely go to the proposition that invention must be found in the statutory class to which the claim is directed. Without raising any question as to the correctness of such decisions, it is clear that they do not support the proposition that an inventive concept as to the relationship or use of **machine** elements may not support the patentability of a **machine** claim in the absence of separate and distinct invention in the physical embodying means *per se*. Thus, in the Court of Appeals' opinion, *Reo Motor Car Co. v. Gear Grinding Machine Co.*, 42 F. 2d 965, was relied upon, the Court quoting the following language from page 967 of such decision:

> "We think it usually will be true * * * that where there are coincident method, machine and product inventions, the underlying meritorious inventive thought will be found in one of the three and the other two will be relatively collateral * * * The improver must first conceive in a general way, the method or plan for such grinding, and must then devise means for effectively and sufficiently maintaining the grinding shape. Until this can be done the conception is not an invention, because it is useless" (R. 359).

But the opinion in the Reo case continues:

> "When, however, the method is reduced to practice so that its utility is demonstrated, the method becomes a patentable invention, as the means also may be"

and the opinion goes on to hold the method claims valid and infringed.

The next case relied upon by the Court of Appeals was *Nestle Le Mur Co. v. Eugene,* 55 F. 2d 854, 857, quoting the following excerpt:

> "Where one discovers a new and useful process for accomplishing a given result, is the obvious mechanical or electrical device, obvious to anyone to whom the proposed method is disclosed patentable apart from the process? We are constrained to the opinion that it is not" (R. 359).

Here again the continuing discussion in the cited decision indicates the limitations of the holding, first, pointing out the fundamental difference between process and machine patents established by *Corning et al., v. Burden,* 15 How. 252, 267, and then proceeding on page 857 to the discussion of other cases as follows:

> "In *Cochrane v. Deener,* 94 U. S. 780, 788, 24 L. Ed. 139, it was distinctly pointed out that a process may be altogether new, and produce an entirely new result, while the machinery 'suitable to perform the process may or may not be new or patentable.' The same thought underlies the language of Mr. Justice Bradley in *Tilghman v. Proctor,* 102 U. S. 707, 728, 26 L. Ed. 279, and the decision in *Risdon Locomotive Works v. Medart,* 158 U. S. 68, 79, 15 S. Ct. 745, 39 L. Ed. 899, where it was held that a process patent was invalid because all that the patentee in-

> vented was a machine. We see no reason why the converse of this is not equally true, or why a machine patent which does not meet all the tests of patentability applicable to machine patents should not be held invalid for that reason, notwithstanding the patentee may have discovered a clearly patentable process. Compare, also, *Expanded Metal Co. v. Bradford*, 214 U. S. 366, 29 S. Ct. 652, 53 L. Ed. 1034."

The last case of *Naivette v. Bishinger*, 61 F. 2d 433, 436 (C. C. A. 6), goes to the same point:

> "There is no contradiction in sustaining validity of a process, which includes clamping as a step in a new combination, and yet to deny validity to the patent for a clamp as a unitary device."

There is of course no authority or justification in such decisions for the proposition that an inventive concept cannot satisfy the constitutional and statutory requirements for invention where both the inventive concept and the embodying machine are in the same statutory class.

Furthermore, the ruling of the Court of Appeals is in direct conflict with the law enunciated in its own decisions in earlier Sixth Circuit cases:

> "where the availability of the old device to use in the new environment is not obvious, either because of intrinsic differences in the quality of the operation to be performed, or because the relationship between the two arts or fields of use is remote, invention may be found in the mere concept of such availability to useful service in the new and different environment (*Herman v. Youngstown Car Mfg. Co.*, 191 F. 579 (C. C. A. 6))"; *Willett Mfg. Co. v. Root Spring Scraper Co.*, 55 F. 2d 858, 859.

> "Judged by the objective and subjective tests which are applicable, and by which we have been guided as well as may be in other cases, we conclude that the District Judge was right in finding the quality of invention to be present in this conception that the old material could be employed for this new use, coupled with the (thereupon) rather obvious mechanical changes which were necessary to make practical the application of the thought. [cases cited]
>
> "The supposed rule of the Locomotive Truck Co. Case, 110 U. S. 493, 4 S. Ct. 220, 28 L. Ed. 222, is much pressed upon us; but that case, as well as *Potts v. Creager*, and all that follow, recognize that the application to a new use may be invention, if there be a sufficient lack of analogy and if there be some adaptation." *Lakewood Engineering Co. v. Walker*, 23 F. 2d 623, 624.

This same rule, as enunciated by Judge Learned Hand has also been consistently followed in the Second Circuit.

> "Assuming, for argument, that the law is absolute that there can be no patent for the new use of an old thing, that is because the statute allows no monopolies merely for ideas or discoveries. If the thing itself be new, very slight structural changes may be enough to support a patent, when they presuppose a use not discoverable without inventive imagination. We are to judge such devices, not by the mere innovation in their form or material, but by the purpose which dictated them and discovered their function." *Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co.*, 18 F. 2d 66, 68.

A further statement of this rule is found in *Gillman v. Stearn*, 114 F. 2d 29, 30 (C. C. A. 2):

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"However, the only objection to patenting a new use is that the statute, §31, Title 35, U. S. Code, 35 U. S. C. A. §31, does not include 'uses' among what can be patented, except so far as they are included within 'arts'—i. e., processes. If, however, an old article must be physically changed, even slightly, to fit the new use, it becomes itself a new 'machine' or 'manufacture,' and the statute is satisfied. In that case the only question open is whether the discovery of the new use demands enough original thought to be deemed an invention.
Constitutionally only 'discoveries' can be patented at all, and the ingenuity needed for the new conception, not the amount of physical readjustment, is the test of a valuable 'discovery.' Topliff v. Topliff, 145 U. S. 156, 163, 164, 12 S. Ct. 825, 36 L. ed. 658; *C. & A. Potts & Co. v. Creager,* 155 U. S. 597, 608, 15 S. Ct. 194, 39 L. ed. 275; *Rockwood v. General Fire Extinguisher Co.,* 2 Cir., 8 F. 2d 682, 686; *Gordon Form Lathe Co. v. Walcott,* 6th Cir., 32 F. 2d 55, 58." (emphasis added.)

This Court has likewise consistently held that a slight physical change in the means for materializing an inventive concept will support patentability. A "trifling" physical deviation was involved in the device held patentable in *Topliff v. Topliff,* 145 U. S. 156. Likewise, in *C. & A. Potts & Co. v. Creager,* 155 U. S. 597, 608, this Court held:

"Indeed, it often requires as acute a perception of the relations between cause and effect, and as much of the peculiar intuitive genius which is characteristic of great inventors, to grasp the idea that a device used in one art may be made available in another, as would be necessary to create the device *de novo.* And this is not the less true if, after the thing has been done, it appears to the ordinary mind so simple as to excite wonder that

it was not thought of before. The apparent simplicity of a new device often leads an inexperienced person to think that it would have occurred to anyone familar with the subject; but the decisive answer is that with dozens and perhaps hundreds of others laboring in the same field, it had never occurred to anyone before. The practiced eye of an ordinary mechanic may be safely trusted to see what ought to be apparent to everyone * * *

"As a result of the authorities upon this subject, it may be said that, if the new use be so nearly analogous to the former one, that the applicability of the device to its new use would occur to a person of ordinary mechanical skill, it is only a case of double use, but if the relations between them be remote, and especially if the use of the old device produce a new result, it may at least involve an exercise of the inventive faculty."

Another Supreme Court case holding an inventive concept plus a non-inventive physical change patentable is extremely pertinent to the point here under discussion as apparent from the following excerpts:

"It is insisted, however, that, as the connecting mechanism had been previously used upon the other side of the machine to ring the bell and to open the cash drawer, the employment of a similar mechanism for actuating the pivoted wing was a case of mere double use, * * *

"It did, however, require thought to conceive the idea (1) that a remedy for the existing defects in the machine lay in the independent operation of the wing; and (2) that such operation could be secured by a mechanical connection with the keys. Given these conceptions, it was more a matter of mechanical skill than of invention to devise such connection, since a similar train of mechanism had been operated by the keys for other purposes. * * *

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> "The cases cited by defendant upon the subject of double use are not applicable; * * * In all these cases the prior uses were such obviously analogous ones that there could be no doubt of the invalidity of the patent." *National Cash Register Co. v. Boston Cash Indicator and Recorder Co.*, 156 U. S. 502; 39 L. ed. 515.

See also *Hobbs v. Beach*, 180 U. S. 383, 393, another case involving a minor change wherein this court found:

> "invention consisting rather in the idea that such change could be made than in making the necessary mechanical alterations."

Continued recognition by this Court of the thoroughly established law that a slight physical adaptation will support the patentability of an inventive concept is indicated by the minority opinion in *Jungersen v. Ostby and Barton Co.*, 335 U. S. 560, 93 L. ed. 235, 241 (1948), adopting Judge Learned Hand's opinion including the following pertinent language:

> "My point is that, if there is a new combination, however trifling the physical change may be, nothing more is required than that, to take the step or steps, added 'invention,' is needed; and 'invention,' whatever else it may be, is within the category of mental activities and of those alone."

While the majority of the Court in such case did not feel that the art of jewelry casting was a distinct or non-analogous art from other types of casting, or that invention was involved in the new use there was no disagreement concerning the principle that a slight physical change may support the patentability of a new concept if there be invention in such concept.

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Thus, the Court of Appeals ruling in the present case:

> "Assuming, but not deciding, that there was inventive thought in the concept of keeping the feed drawer from touching the mold so as to prevent the transmission of vibration to it from the mold, the concept itself was not patentable unless it became materialized by means themselves new and not within the expected skill of the art" (R. 359).

is clearly in direct conflict with the established law as enunciated by the Sixth Circuit, other circuits and this Court. Furthermore, such ruling is clearly inimicable to the validity of all mechanical inventions, any of which may be analytically reduced into concepts of desired relationships between machine elements on the one hand and physical materializing structure on the other hand in such a manner as to exhaust all inventive aspects in the concepts as distinguished from the materializing means. To promulgate such unprecedented and unwarranted restriction on the nature of inventive act which will support patentability as to require that it reside in **structure** rather than **concept** would, if permitted to prevail, ultimately result in the judicial elimination of the entire statutory class of mechanical inventions since the ultimate mechanical components of any new and inventive machine may be found in the prior art and as, observed by Judge Learned Hand,

> " 'invention,' whatever else it may be, is within the category of mental activities and of those alone." *Supra*

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POINT II

That the description of an art or process is sufficient if it enable persons skilled in the art to use it without making any experiments or changes involving invention as distinguished from experiments required to produce the best result; and the patentee need not describe in detail what was already known to the art but may begin at the point where his invention begins and describe what he has made that is new and what it replaces of the old.

The Court of Appeals held the Gelbman method patent invalid "for failure to fully disclose a complete operational method" (R. 364).

In an attempt to justify this holding, the Court seized upon the testimony of the witness Besser, a licensee, as to experimentation in trying out "various speeds of the vibrating member, and the various amounts of weights to give various vibrating forces, [and] various sizes of motors to give the results desired" (R. 31); and, entirely on its own initiative without any argument or suggestion by counsel or the district court, erroneously stated:

> "There is no mention in the specification of the vibrating force required or its amplitude nor do the drawings in any way assist us" (R. 363).

Then, by expanding and distorting the import of Besser's testimony, without any explanation or record justification whatsoever, the Court reached the wholly unwarranted inferential conclusions that Besser:

> "could not make a successful block without organizing a new machine, incorporating elements of both Gelbman and Scott and undertaking extensive experiments of his own before it could be constructed to successfully function" (R. 363).

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and that:

> "Besser's experimentation was basic to a useful method and imperative to disclose, even to those skilled in the art, the successful functioning of the patented method" (R. 364).

In fact, the amplitude and vibrating force as well as all other aspects of the vibrating apparatus, are not only mentioned but fully described in complete qualitative detail in both specification and drawings as apparent from the following excerpts from the Gelbman method patent (Vol. II, R. 354) reproduced herein for convenient reference:

> "It is proposed to construct the vibration unit in a particular manner so that vibrations in all directions, except the vertical, are immediately absorbed and dissipated into the foundation, while the vertical vibrations are transmitted upwards by a stiff but relatively flexible member to the mold of the block machine.
>
> "Specifically, it is proposed to utilize a pair of flat leaf springs arranged in a particular manner for transmitting the useful vibrations up to the mold.
>
> "Furthermore, the invention contemplates supporting the mold in a particular manner to obtain the full effects of the jolting ability of the vibrating unit and at the same time limiting vibrations from reaching other portions of the block machine.
>
> "With respect to the vibration unit itself it is proposed to use a rotary vibrator and to use a specific principle in converting the rotary vibration into a reciprocating vibration in one direction or one plane only, namely, the vertical of the mold. (p. 1, Col. 2, l. 26-49).
>
> • • • • •

"Between the channel members 45 the vibration unit is mounted. This vibration unit consists of a pair of spaced bearings 51 and 52 (see Fig. 7) vertically slidably mounted between the channel members 45. These channel members are placed with their flanges directed away from each other and with their backs towards each other. It is between the backs of these channel members that the bearings 51 and 52 are arranged. Resilient pads 53 are interposed between the front and rear faces of each bearing and beneath the bottom face of each bearing which is to be separated from the concrete block 46. It should be clear that the bearings 51 and 52 are adapted to slide vertically upwards and downwards and transmit vertical vibrations, but are insulated from vibrations in all other directions. A shaft 54 is rotatively mounted in the bearings 51 and 52 and at the center is provided with a thrust bearing consisting of a pair of spaced flanges 55 between which there engages a tongue 56 mounted upon the rear channel member 45. This thrust bearing holds the shaft 54 from longitudinal motion, but permits vertical motion and also rotation. A pair of offset weights 57 are mounted on the shaft 54. One end of the shaft 54 extends from the bearing 52 and is joined by a flange coupling 58 with a motor 59 mounted in a pit 60 formed in the foundation 15. The arrangement is such that when the motor 59 operates the shaft 54 will be rotated and the offset weights 57 will tend to cause the shaft 54 to vibrate in a rotary direction. Since the shaft 54 is rotative in the bearings 51 and 52 which are limited to slide only in the vertical direction, the rotary tendency of vibration will be changed to a reciprocating vibration arranged in the vertical plane. (p. 3, Col. 1, l. 24-61).

* * * * *

"In the space between the walls 44a and 44b the top member 44c and the partition 44d of each support member 44 is formed with superimposed openings 61 and 62. Through each pair of superimposed openings a bolt 63 passes. Each of these bolts also extends upwards and through corresponding openings in the base plate 42. *The bolts 63 have a pair of lock nuts 64 at their top ends and a similar pair 65 at their bottom ends, and these lock nuts are so adjusted so that normally there is a slight space 66 between the bottom pair of nuts 65 and the partitions 44d. This space 66 controls the amplitude of vibration of the mold 34. If desired this space may be increased or decreased by proper adjustment of the nuts 64 and 65 of each of the bolts 63.* The ribs 43 normally rest on the head portions 44c of the support members 44, but as the mold vibrates these rib portions 43 rise off the head portions 44c to positions at which the nuts 65 strike the portions 44d. This is the limit for the upward motion of the vibration of the mold. The downward motion is arrested when the ribs 43 strike the head portions 44c of the support members 44. (p. 3, col 2, l. 3-27; emphasis added).

• • • • •

"The vibration unit is connected to the mold support plate 42 in the following manner: There are a pair of vertical rods 67, the bottom ends 67a of which are screwed into threaded openings in the tops of the bearings 51 and 52. The upper ends are rigidly attached by bolts 68 to the plate 42. The rods 67 are made from top and bottom sections 67b and 67c, respectively. Flat, relatively stiff leaf springs 69 are welded between the inner ends of the sections 67b and 67c, respectively. These flat leaf springs are arranged with the sides parallel to the vibrator shaft 54. Vertical vibrations from the bearings 51 and 52 will be transmitted by the rods 67 to the mold support plate 42 and thus to the mold 34 which is directly attached on the plate 42. (p. 3, col. 2, l. 33-48).

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"The electrical wiring of the device is shown in Fig. 18. There is a three-line source of power 205 which enters a control box 206 which has a handle 207 by which a three pole switch may be opened and closed. In each line there is a fuse 208. The three lines continue to a magnetic switch box 210 which has a three pole switch 211 adapted to be closed by a solenoid 212. This switch is normally urged open by a spring 213 and when the solenoid is energized, will close. This switch 211 controls the electric motor 59 [a three-phase squirrel cage induction motor, in accordance with electrical symbol 76 of the Rules of Practice in the United States Patent Office, having a characteristic speed in the order of 3500 r. p. m. in the case of a two pole field] which operates the vibrator unit of the device. The solenoid 212 is connected with a time switch box 214. More specifically, the solenoid 212 is in a circuit which connects a time switch 215 in series with a holding solenoid 216 of a mercury control switch 217 arranged to control the circuit of the solenoid 212. The mercury switch 217 is urged into an open position by a spring 218. It is adapted to be closed by the solenoid 216. The control solenoid 216 is in circuit with a hand operated switch 219 which is arranged in a box 220 mounted on the front of the block machine, preferably immediately adjacent the control handle 104. The wiring may readily be followed. The arrangement consists in the fact that normally the switches 211, 217 and 219 are open. Of course, the control switch 207 must be closed at all times. To operate the vibrator of the block machine the switch 119 is just momentarily closed by touching it. This will close the circuit through the solenoid 216 which immediately becomes energized to close the mercury switch 217. When the mercury switch closes a holding circuit through the solenoid 216 is also closed so that the mercury

switch 217 remains closed even though the hand switch 219 is immediately released and opens.

"When the switch 217 is closed the circuit through the solenoid 212 is closed and the switch 211 is closed by the solenoid which then closes the motor circuit and the motor 59 operates. The motor 59 will continue to operate until the time switch 215 opens. It may be set for various desired times. A desirable time, according to the operation, is five seconds. After this period the circuit is broken by the switch 215. This immediately breaks the holding circuit of the solenoid 216 and then the spring 218 immediately opens the switch 217. The circuit is thus broken through the solenoid 212 and the spring 213 opens the switch 211. The parts are now in their original postions and the cycle is ready to be repeated. (p. 6, col. 1, l. 46, col. 2, l. 24).

• • • • •

"When the shaft 128 turned 90° it moves the radial arm 151 and the connecting arms 153 forwards and so moves the feed drawer 30 forwards to a position over the mold. As soon as the handle 104 was turned through the 90° the operator also is required to close the switch 219 which will set the vibrator into motion. As the feed drawer advances, or during a portion of the time that it advances, or after it has reached its position over the mold, depending merely on the adjustment of the machine, the vibrator will be operating. When the vibrator operates the motor 59 rotates driving the shaft 54 and causing vertical jolts to be transmitted by the bearings 51 and 52 through the medium of the rods 67 to the mold. (p. 7, col. 1, l. 1-15).

• • • • •

"It is pointed out that the vibration unit will throw the mold through an amplitude equal to the

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height of the space 66. The vibration unit has sufficient power to normally throw the mold through a larger amplitude than the height of the space 66, but the limiting of the amplitude of vibration of the mold produces a jolt at both the top and bottom ends of said amplitude. This jolting effectively packs the concrete material in the mold. However, as already stated, the top of the concrete will not be satisfactorily packed since it is loose to jiggle around. When the pressure head falls down upon the concrete material in the mold, which continues to vibrate, the top of the concrete material will be rapidly packed and smoothed out. When the pressure head is resting on the concrete material in the mold it will progressively descend as the concrete becomes packed. When thus descending, the pressure head will reduce said amplitude of vibration of the mold, to an amount smaller than the said space 66. This reduction in amplitude of vibration of the mold, to an amount smaller than disturbance of the concrete material, which without the pressure head, tends to jiggle the top of the concrete mass loose. The reduction of the amplitude of vibration of the mold will also increase the jolt shock, since the power of the vibrating unit is constant, and consequently when the amplitude of vibration is reduced the jolt shock must increase" (p. 7, col. 1, l. 57—col. 2, l. 12—emphasis added).

In view of the above patent disclosure of a three phase squirrel cage induction motor directly coupled to a rotatable shaft carrying off-center weights together with rods for transmitting shaft vibration produced by the off-center weights to the mold, it becomes a matter of straight mathematical computation to determine the centrifugal force, weight size, and motor power required to throw any mold having any given mass through any desired amplitude of

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vibration. **Accordingly, the supposed deficiency of disclosure consists only in the patentee's description of the adjustable space 66 as a *"slight"* space rather than specifying the exact physical dimension.** But expressions of this type have consistently been held by this Court to be sufficient:

> "The next objection to the patent which prevailed in the circuit court of appeals is that its terms are too vague, because the extent of the factor of pitch is not defined except by the terms 'substantial' and 'high.' • • •
>
> "Expressions quite as indefinite as 'high' and 'substantial,' in describing an invention or discovery in patent specifications and claims, have been recognized by this court as sufficient. In *Tilghman v. Proctor,* 102 U. S. 707, 26 L. ed. 279, the claim sustained was for 'the manufacturing of fat acids and glycerin from fatty bodies by the action of water at a high temperature and pressure.' See also *Providence Rubber Co. v. Goodyear,* 9 Wall. 788, 794, 19 L. ed. 566, 568; *Mowry v. Whitney* ,14 Wall. 620, 629, 20 L. ed. 860; *Lawther v. Hamilton,* 124 U. S. 1, 9, 31 L. ed. 325, 328, 8 Sup. Ct. Rep. 342; *Carnegie Steel Co. v. Cambria Iron Co.,* 185 U. S. 403, 436, 46 L. ed. 968, 985, 22 Sup. Ct. Rep. 698; *Abercrombie & F. Co. v. Baldwin,* 245 U. S. 198, 205, 62 L. ed. 240, 246, 38 Sup. Ct. Rep. 104." *Eibel Process Co. v. Minnesota & Ontario Paper Co.,* 261 U. S. 45, 65, 66.

To hold a patent covering subject matter which the patentees spent over nine years developing and which was recognized by the two foremost concrete block machinery manufacturers in the United States as fully disclosing an important invention contributing vitally to a revolutionary advance in the industry—as evidenced by their acceptance

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of licenses and payment of substantial royalties thereunder throughout the past ten years—invalid for such a trivial supposed insufficiency of disclosure must, when fully understood, be recognized as a radical departure from, and clearly in conflict with, the recognized standards repeatedly enunciated by this Court.

Furthermore, in reaching its unwarranted conclusions from the Besser testimony of experimentation, the Court of Appeals totally ignored the distinction between experimention to obtain **best** or **desired** results on the one hand and experimentation necessary to obtain an **operative** result or a **successful** block on the other hand. It is entirely compatible with an operative and successful first result that experimentation with different vibration forces be made in order to obtain desired results, such, for example, as minimum time of vibration cycle, maximum uniformity of density, minimum power expenditure, best vibration for various individual block materials used, etc. (R. 50). There is no evidence in the record that any experimentation whatsoever was required in order to obtain an operative result or successful block.

The Court of Appeals further ignored the thoroughly established and generally recognized distinction between experiments or changes involving **invention** as distinguished from experiments required to produce the best results. The general rule concerning this distinction is stated in *69 Corpus Juris Secundum* under §104 Description of Invention, b. Sufficiency of Description, in the following subsection heading:

> "(2.) Art or Process
>
> "The description of an art or process must be such as to enable persons skilled in the art to use it without making experiments or changes involving invention, as distinguished from experiments required to produce the best results" (p. 432).

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The Court of Appeals further ignored the recognized distinction between description required as to inventive subject matter, first disclosed in the patent in question, as contrasted with the description required as to subject matter already known to the art and merely collateral to the inventive method disclosed. Thus, in stating the requirements for an inventor's disclosure this Court has said:

> "He may begin at the point where his invention begins, and describe what he has made that is new, and what it replaces of the old. That which is common and well known is as if it were written out in the patent and delineated in the drawings." *Webster Loom Co. v. Higgins, et al.*, 105 U. S. 580, 586.

Applying such rule to the present case it is clearly apparent from the Court of Appeals' own opinion that:

> "Gelbman was not, nor did he claim to be, an innovator in the use of vibration to compact concrete material in a mold" (R. 358).

and therefore should not be required to disclose quantitative details as to vibrating apparatus which is merely collateral to the inventive method disclosed.

The Court of Appeals was in clear error in assuming that:

> "Neither of the Gelbman patents • • • received commercial embodiment" (R. 356).

and in concluding that the licensee Besser:

> "could not make a successful block without organizing a new machine, incorporating elements of both Gelbman and Scott" (R. 363).

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On the contrary, the record evidence discloses that another licensee had followed the details of the Gelbman patent disclosure and had made a successful block as indicated by the following undisputed testimony of the witness Besser on cross examination:

> "Q. And you don't know that a Gelman machine, just as it is shown up in the drawing ever was made?
>
> "A. The other licensee under these Gelbman Patents, the Stearns Company, made a machine more exactly in details of construction, overall details of minor details of construction as shown in the patent.
>
> "Q. And are they still making it?
>
> "A. Yes" (R. 48, 49).

Thus, Besser's election to employ the specific vibrating apparatus of Scott (R. 31) rather than that disclosed in the Gelbman method patent was purely an optional one rather than an election to which he was forced by any deficiency of the Gelbman patent disclosure as mistakenly inferred by the Court of Appeals.

The fact that Besser did not attempt to construct a machine incorporating the specific vibrating apparatus disclosed in the Gelbman patents actually negatives any legitimate inference from Besser's experimentation with the Scott vibrating apparatus that one skilled in the art, following the teachings of the Gelbman disclosure as closely as possible, would be unable to obtain an operative and successful result without extensive experimentation. There was no evidence whatsoever as to any experimentation by the Stearns Company which did employ the specific apparatus disclosed in the Gelbman patent.

The decisions relied upon by the Court of Appeals (R. 363) in no way support its holding of insufficient disclo-

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sure in the present case. The deficiency involved in the *Great A. & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147 was that the only novel element upon which patentable invention could be based, namely, an extension of the counter, was not properly claimed, as is clear from the following excerpt:

> "since the courts below perceived invention only in an extension of the counter, we must first determine whether they were right in so doing. We think not. In the first place, the extension is not mentioned in the claims, except, perhaps, by a construction too strained to be consistent with the clarity required of claims which define the boundaries of a patent monopoly" (p. 149).

In *Schriber -Schroth Co. v. Cleveland Trust Co.*, 311 U. S. 211 flexible or yieldable webs in a piston construction urged as a main element of the **inventive concept** were neither described nor claimed in the patents. Again, in *Permutit v. Graver Corp.*, 284 U. S. 52, the alleged **inventive concept** of a "free" zeolite bed upon which patentability depended is neither described in the specification nor mentioned in the claims. Thus, in each of these cases, description and/or claming were lacking at the precise point of the **inventive concept** mainly relied upon for patentability. But, in contrast, in the present case effective vibrating means in compacting concrete blocks was, as directly acknowledged by the Court of Appeals, an element already known to the art and collateral to the inventive concept of utilizing such known element in a particular succession of method steps to obtain unprecedented results.

In further contrast in the present case, the entire disclosure of the Gelbman method, including the vibrating apparatus, is one of the most complete ever observed by

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petitioners' counsel and clearly meets recognized standards for sufficient disclosure as indicated by the authorities mentioned above as well as by the following excerpts from further decisions of this Court:

> "The specification of the patent is not addressed to lawyers, or even to the public generally, but to the manufacturers of steel; and any description which is sufficient to apprise them in the language of the art of the definite feature of the invention, and to serve as a warning to others of what the patent claims as a monopoly, is sufficiently definite to sustain the patent." *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 437.

> "But it is said that the patent in suit discloses no means of practically operating the method shown, and therefore, as said by the learned judge in the third circuit, 'It is but the expression of a happy thought;' but the requirement of the patent law, in order to make a method or process patentable, is that the patent shall indicate to those skilled in the art the adaptation of means to put it into practice.
>
> "We think this record amply discloses, while no complete mechanism is pointed out in the specifications, enough to indicate to those skilled in such matters a mechanism whereby the method of the patent can be put into operation * * *
>
> * * * * *
>
> "The important thing in this patent is a method of procedure, not the particular means by which the method shall be practiced." *Expanded Metal Co. v. Bradford*, 214 U. S. 366, 379, 380.

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> "Methods and apparatus for moving concrete by compressed air had been previously invented. See Smith's patent, 122,498. The court below, in No. 3, indicated that this had not been found practicable. There is no support in the record for any such finding and against it stands the presumption of operability from its patenting." *Powers-Kennedy Contracting Corp. v. Concrete Mixing & Conveying Co.*, 282 U. S. 175, 184.

Such decisions have been uniformly followed by the Patent Office and Court of Customs and Patent Appeals:

> "It is well settled that a disclosure in a patent application will not be held inoperative if it may be made operative by one skilled in the art without the exercise of the inventive faculties." *Anderson v. Walch*, 152 F. 2d 975, 980 (CCPA).

POINT III

That a broad and indefinite title of a patent may not supplant specific limitations contained in a claim in suit and definite purposes set forth in the specification so as to render analogous and anticipatory a patent disclosing an apparatus used in a clearly nonanalogous art for accomplishing a diametrically opposite end result relative to the subject matter of the claims and specification of the patent in suit.

The Court of Appeals' holding that the Taylor patent (R. 228; Vol. II, R. 377) in the art of washing and separating ore is in an analogous art is contained in the following excerpt:

> "The challenge to Taylor on the ground that it was a patent in a nonanalogous art must be rejected. While Taylor described his patent as an apparatus for concentrating materials and was

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> directed to the concentrating of finely divided ores, coal or minerals in general, so was Scott. He entitled his patent as 'an apparatus for treating materials.' While he illustrated it by treatment of concrete, he described it as applying to all building materials" (R. 365).

The above brief comparison of the Taylor and Scott patents seizes upon the term "concentrating" as used in the title of the Taylor patent and the indefinite title of the Scott patent and because of the divergent meanings that can be given to the term "concentrating", draws an analogy between the two patents. This is a resort to petty formalism that disregards substance and actually amounts to a mere play upon words. It completely ignores the basic fundamental disclosures of the patents when viewed, or appraised, in their respective entireties. The use of the term "concentrating" in the title of the Taylor patent, which patent is clearly directed to a type of concentrating that involves **separation** of divided ore particles by passing them through the interstices of a vibrating sieve in a bath of flowing water, is clearly distinct from, and the direct antithesis of, the **compacting** of a concrete mix or aggregate in a concrete block mold so as to form a molded, tightly packed coherent concrete block.

It is, we submit, clearly improper in a patent infringement action to rest the determination of question of analogous art and anticipation solely on a comparison of the titles of patents under consideration while ignoring the complete disclosures of such patents. Such approach, reflected in the foregoing quotation from the Court of Appeal's opinion, ignores limitations clearly expressed in claim 6 in suit of the Scott patent, although no principle of the patent law is more firmly established than that in any

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patent infringement action the scope of the patent in suit is to be determined by the claim in suit as interpreted in the light of the patent's disclosure. *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 271, 277. *Smith v. Snow*, 294 U. S. 1, 11.

Turning to claim 6 in suit (Vol. II, R. 352) we find the pertinent art defined at the outset, "In apparatus for molding of plastic materials like concrete". This unquestionably limits the invention and art to which it applies, in the first place, to an apparatus for molding and secondly to the material being treated of plastic materials like concrete. The term "mold" which is repeated no less than five times in the claim, and a further limitation therein calls for "means for removing the formed mass of material from the mold."

Turning to the specification of the Scott patent we find the purpose of the invention defined as follows:

> "This invention relates to improvements in the manufacture of building elements of concrete and other materials and more particularly the invention appertains to an improved method and means *for intermixing, uniting, and compacting the ingredients of the material.* (p. 1, col. 1, l. 1-6).
>
> "According to my invention, I subject the mixture to a very rapid and vigorous vibration to obtain a product of great strength, and compactness, and employ a vibrating movement that tends *to maintain the various ingredients evenly distributed throughout the mixture.* (p. 1, col. 1, l. 32-37).
>
> • • • • •
>
> "The vibration is such as to slide and roll the ingredients of the mixture on and against one another and force and pound them against the sides

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of the mold so that they are thoroughly intermixed and united. *Furthermore by reason of the fact that settling is largely prohibited by the character of the vibration the resulting product has great uniformity.*" (p. 2, col 2, l. 1-8).

The fact that Taylor described his vibrating sieve, used for the purpose of **separating** finer particles from larger ones, as an "apparatus for concentrating materials" in the title of his patent does not alter the basic, fundamental fact that the apparatus disclosed by Taylor has for its end purpose the end result of completely **separating** finer particles of the material being treated from the larger particles, a diametrically opposite one from the **compacting** end result sought for, and surprisingly achieved, by Scott.

The fact still further remains that although the Taylor patent issued in 1908, no one in the concrete-block making industry ever thought of employing the Taylor device or any equivalent thereof throughout the more than thirty years during which the art was still struggling along with the old-time concrete block tamping machines.

The opinion of the Court of Appeals also ignored completely the fact that the Taylor patent was a file-wrapper reference considered by the Patent Office in its examination of the Scott patent (R. 258) and that, as admitted by defendants' expert on cross-examination, even if one skilled in the art had before him the disclosures of the Taylor and Ferguson (R. 234; Vol. II, R. 334) patents, upon which defendant principally relied upon at the trial to challenge the validity of the Scott patent, the reconstruction of an entire new machine would be involved in order to produce from their disclosures a concrete-block making machine having the combination of elements set forth in claim 6 of the Scott patent (R. 263). No suggestion for any such reconstruction,

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as admitted by defendants' expert, is to be found in either one of the patents relied upon by defendant (R. 263) and certainly is not to be found in Taylor.

Coming now to the holding of invalidity of the Scott patent by the District Court in its original opinion on the grounds of aggregation (R. 327, 329), and the adoption thereof by the Court of Appeals (R. 365), the original holding of the District Court was primarily predicated upon a misconception and misinterpretation of the file-wrapper history of the Scott patent (R. 326) and further upon a most unusual and unprecedented elimination of consideration by the Court of the resiliency feature (R. 327) which forms the essence and heart of the Scott invention. After rehearing, the District Court was convinced that it was in error in holding the Scott patent invalid as covering an aggregation (see opinion on rehearing (R. 340)). The Court of Appeals, however, stated:

> "Our view is that the court was right in the first place. The uniting of vibration and ejecting means in a unitary structure was but an aggregation, each performing an old function in substantially the same old way. (citing cases)." (R. 365.)

The cases cited by the Court of Appeals in its opinion are based upon the use of old elements or means in a combination in which the elements merely perform the same function as performed by them in their old environment without any of them modifying the other or contributing cooperatively to the end result. In the instant case the end result is not merely the production of just another concrete block but, as stated by the District Court in its opinion on rehearing,

> "the Scott patent goes beyond the category of just another block. By it one got a better block, cheaper and at greater speed." (R. 340.)

Due cognizance should be given to the fact that after the concrete block is formed in the mold, it must be removed therefrom. The combination of the means for removing the formed mass of material from the mold after it has been compacted therein is essential for a complete operative combination. In the Scott patent the supporting frame by which the mold is carried also serves as a mounting for the block removal or ejecting means. The interpositioning of the resilient means between the mold and the frame which permits the desired form of intense compacting vibration to be imparted to the mold and likewise serves to avoid the imparting of vibration to the elements of the ejecting means mounted on the frame. The ejecting means, however, so shielded from objectionable vibration is so mounted upon the frame to be immediately available to perform its ejecting function as soon as the block is completely formed. As mentioned in the Scott patent:

> "It is desirable when the product is being ejected out of the mold box to vibrate the latter slightly to loosen the material from the interior sides of the mold and to allow ejection more freely and with less resistance by friction and consequently with less consumption of power as well as less danger of spoiling or distorting." (p. 3, col. 1, l. 40-46).

Due cognizance should be given to the fact that if, as we submit, the Taylor patent is in a non-analogous art, it cannot constitute a proper anticipation for the subject matter of claim 6 under the established law thoroughly recognized by decisions in the Sixth Circuit and this Court:

"where the availability of the old device to use in the new environment is not obvious, either because of intrinsic differences in the quality of the operation to be performed, or because the relationship between the two arts or fields of use is remote, invention may be found in the mere concept of such availability to useful service in the new and different environment. (*Herman v. Youngstown Car Mfg. Co.*, 191 F. 579 (C. C. A. 6);" *Willett Mfg. Co. v. Root Spring Scraper Co.*, 55 F. 2d 858, 859 (C. C. A. 6).

"Judged by the objective and subjective tests which are applicable, and by which we have been guided as well as may be in other cases, we conclude that the District Judge was right in finding the quality of invention to be present in this conception that the old material could be employed for this new use, coupled with the (thereupon) rather obvious mechanical changes which were necessary to make practical the application of the thought. [Cases cited].

"The supposed rule of the *Locomotive Truck Co.* case, 110 U. S. 493, 4 S. Ct. 220, 28 L. Ed. 222, is much pressed upon us; but that case, as well as *Potts v. Creager*, and all that follow, recognize that the application to a new use may be invention, if there be a sufficient lack of analogy and if there be some adaptation." *Lakewood Engineering Co. v. Walker et al.*, 23 F. 2d 623, 624 (C. C. A. 6).

Furthermore, entirely aside from the Taylor patent being in a non-analogous art, Taylor does not disclose the same elements as disclosed by Scott. The Taylor elements do not perform the same function as performed by the Scott elements. Therefore, we do not have here a combination of old elements in Scott which perform their old functions

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in substantially the same way as the elements perform in their old environments. The cases of *Toledo Pressed Steel Co. v. Standard Parts Inc.*, 307 U. S. 350; *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545; and the *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, cited by the Sixth Circuit Court of Appeals, all involving aggregations of old elements performing only their old functions, do not properly apply to the situation presented in this case. What we have in Taylor, is, as we have stated, a function of separating and not compacting materials. What we have in Scott is the compacting of a formed mass of material in a mold. This is the purpose and function of the Scott apparatus, a function that would be utterly incapable of being performed by the apparatus shown in the Taylor patent. We do not have in Scott, therefore, a combination of old elements each performing an old function in substantially the same way as performed by the same elements in their former environment.

The Sixth Circuit decision in *Egry Register Co. v. Standard Register Co.*, 267 F. 186 involved a completely parallel fact situation concerning the defense of aggregation wherein the court below held the claims directed to the combination of feed mechanism and cut off mechanism in a duplicate sheet register to cover a proper combination:

> "We think the claims of the Schirmer patent in suit are not subject to the defense of mere aggregation. True, the cutting-off process does not occur simultaneously with the feeding process. It is enough that the two elements so coact that, as a consequence thereof, a new and useful result, and not a mere aggregation of several results follows. But both the feeding and tearing off are necessary to an effective register." *Supra* p. 191.

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Likewise, in the Scott patent the ejection does not occur simultaneously with the compacting but both are necessary to an effective block making machine.

A question of non-analogous art was also involved in the Ergy case wherein prior art references relating to the feeding of duplicate motion picture films in the process of printing were held non-analogous to the feeding of duplicate order sheets in an autographic register. The decision in the Ergy case relative to non-analogous art follows the principles established by this Court in such decisions as *C. & A. Potts & Co. v. Creager,* 155 U. S. 597, 607, 608; *National Cash Register Co. v. Boston Cash Indicator & Recorder Co.,* 156 U. S. 502, 514-517; and *Hobbs v. Beach,* 180 U. S. 383, all of which are in clear conflict with the holding of the Court below in the present case.

POINT IV

That implied limitations may not be read into a claim in a patent infringement action to form the basis for a holding of noninfringement when such limitations are expressly contained in other claims of such patent and thereby constitute express claim distinctions.

A. Claim 2 of the Gelbman method patent (Vol. II, R. 354).

Claim 1 of the Gelbman method patent calls for "moving a feed drawer with a plastic material *across a vibrating mold*". In contradistinction, Claim 2 calls for "moving the said drawer until it is superimposed on the mold, vibrating the mold during engagement of said feed drawer".

The patent specification states:

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> "As the feed drawer advances, or during a portion of the time that it advances, *or after it has reached its position over the mold,* depending merely on the adjustment of the machine, the vibrator will be operating." (p. 7, col. 1, l. 7-11)

In defendants' machine, the vibrator operates **after the feed drawer has reached its position over the mold** (R. 361), and thus admittedly conforms precisely to the last-mentioned expressly suggested alternative in the patent specification for starting mold vibration. Clearly, Claim 1 literally specifies mold vibration while the feed drawer is traveling to its position over the mold. It is equally clear that Claim 2 is not so limited, calling merely for successive steps, "moving the [feed] drawer until it is superimposed on the mold, vibrating the mold *during engagement of the feed drawer*".

Purporting to give the phrasing of Claim 2 its "ordinary meaning" (R. 360), the Court below proceeded to construe Claim 2 precisely as if it had the limitation of Claim 1 calling for the mold to be vibrating as the feed drawer advances over it. In so doing, it has clearly misconstrued the word "during" to require the meaning "throughout" when it is perfectly clear that such expression is completely satisfied by the primary dictionary meaning "within the time of". For example, the expressions, "There was an explosion *during* the night" or "It rained *during* the night", under no application of "ordinary meaning" could be construed to require either an explosion or rain continuing throughout the entire night.

Such unduly limited construction of Claim 2, in the face of the express more narrow limitation of Claim 1 and the express endorsement in the patent specification of the precise operation employed in defendants' machine which falls clearly within the literal scope of Claim 2, violates the

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most rudimentary principles of claim construction. The irony of such construction is particularly emphasized by the fact, fully admitted by defendants, that no material is discharged into their mold until the feed drawer has reached its position over the mold (R. 145) so that vibration of the mold prior to such time could have no conceivable useful purpose.

Statements during prosecution of the application, made with reference to the language of claim 1, although mistakenly coupled in argument with claim 2, as to the advantage of vibrating during the entire filling period and urged by defendants as having the estoppel effect of limiting Claim 2 to the scope of Claim 1, in fact have no pertinence whatsoever in distinguishing defendants' operation which equally employs vibration during the entire filling period.

Thus, while the Court of Appeals' holding purports to be based on "natural meaning," it is clearly in conflict with its earlier decisions such as found in *Chamberlain Metal Weather Strip Co. v. Barringer*, 105 F. 2d 880, 882:

> "appellant urges that the hook is not essential to the operation of the device. It is not an element of the claims in suit, although other claims present this feature of the construction. Appellant urges that the fact that this particular element is not present in claims 9 and 14, and is expressly specified in another group of claims, requires that the element not be read into the claims in suit. *Cadillac Motor Car Co. v. Austin*, 6 Cir. 225 F. 983, 985. We agree with appellant upon this point. The patent presents a group of narrow claims limited by the specific reference to the hook, and a group of broader claims not so limited. The limitations of another set of claims can-

not be imported into the claims in suit. *French v. Buckeye Iron & Brass Works*, 6 Cir., 10 F. 2d 257, 262."

Also, with decisions of this Court in *Symington v. National Malleable Castings Co.*, 250 U. S. 383, 385:

> "Whether the Byers pocket was to be integral or might be in two or more parts is a matter about which the two courts differed. In the Maine suit it was held that the claims were not limited to in integral pocket, but in the Illinois suit the ruling was the other way. The former view, as it seems to us, is the right one. There is nothing in Byers's claims which were sustained, indicating that the pocket is to be integral, while there is a distinct call for such a pocket in claim nine. The difference in terms points persuasively to a difference in purpose."

and in *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 339 U. S. 605. 607:

> "In determining whether an accused device or composition infringes a valid patent, resort must be had in the first instance to the words of the claim. If accused matter falls clearly within the claim, infringement is made out and that is the end of it."

See also the decision of this Court in *Smith v. Snow*, 294 U. S. 1 going beyond the present case to find infringement even where the specification does not disclose defendants' operation, as indicated by the following language:

> "We may take it that, as the statute requires, the specifications just detailed show a way of using the inventor's method, and that he conceived that particular way described was the best one. But he is not confined to that particular mode of use since the claims of the patent, not its specifications, measure

the invention. *Paper Bag Patent Case (Continental Paper Bag Co. v. Eastern Paper Bag Co.)*, 210 U. S. 405, 419, 52 L. ed. 1122, 1128, 28 S. Ct. 748; *McCarty v. Lehigh Valley R. Co.*, 160 U. S. 110, 116, 40 L. ed. 358, 361, 16 S. Ct. 240; *Winans v. Denmead*, 15 How. 330, 343, 14 L. ed. 717, 722. While the claims of a patent may incorporate the specifications or drawings by reference, see *Snow v. Lake Shore & M. S. R. Co.*, 121 U. S. 617, 630, 30 L. ed. 1004, 1008, 7 S. Ct. 1343, and thus limit the patent to the form described in the specifications, it is not necessary to embrace in the claims or describe in the specifications all possible forms in which the claimed principle may be reduced to practice." *Smith v. Snow*, 294 U. S. 1, 11.

B. Claim 6 of the Scott patent (Vol. II, R. 352).

As the opinion of the District Court is the only opinion which made a direct holding of non-infringement by the accused defendants' machine of claim 6 of the Scott patent, the only claim thereof upon which we now rely, we direct our discussion to the opinion of the District Court re Scott infringement (R. 326, 327). The main distinctions relied upon by the District Court in holding non-infringement were

a. That the resilient means interposed between the mold and the frame in defendants' machine did not perform the same supporting function in defendants' machine that it did in Scott; and

b. That in defendants' machine the pallet (plate for carrying the block after ejection) was located against the bottom surface of the mold for downward ejection of the block through the bottom of the mold, while in Scott the pallet was located inside the mold for ejection of the block upwardly through the top of the mold.

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In connection with the first distinction relative to the supporting function of the resilient means in Scott, Claim 1 calls for "springs carried by the frame for *supporting* the mold," Claim 2 calls for "resilient means on said frame for *supporting* said mold," Claims 3 and 4 call for "resilient means *supporting* said mold by and above said frame," Claim 5 calls for "resilient *supports* for the mold," but in contradistinction to these other claims, Claim 6 omits any mention of any supporting function and calls merely for "a resilient means interposed between the mold and the frame *whereby the mold can be vibrated substantially independently of the frame.*"

That defendants' mold does in fact vibrate "substantially independently of the frame" is abundantly and conclusively established by the record evidence and was fully admitted by both defendants' counsel and principal witness, Mr. Milewski, without any subsequent modification or retraction which would in any way qualify such admission. Thus during the Court's inspection of the defendants' machine at Midland, the Court directly observed the rubber blocks interposed between the mold and the frame and the complete isolation of mold vibration from the frame, as indicated most clearly by the following:

> "The Court: Here is your rubber. I notice there is no agitation at all on that lower frame but there is agitation on this upper frame" (R. 131).

The next day during examination of defendants' principal witness, Mr. Milewski, the Court referred to such observation at the inspection of defendants' machine:

> "The Court: What were you talking about that I put my finger between yesterday and said one was vibrating, the other wasn"?
> "Mr. Liverance: That was at one time.

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"A. That is right. These points. [Referring to the mold and frame on either side of the rubber blocks.]

"The Court: And you are talking about that rubber that is in there, and you could feel the rubber in there?

"A. That is right" (R. 138).

* * *

"The Court: You could put your hand on the rubber and you could feel the rubber vibrate" (R. 139).

* * *

"The Court: When I put my finger in here yesterday and I am pointing to the rubber—

"A. Yes.

"The Court: When this [the rubber] was vibrating, that [the mold] was vibrating, but this down here [the frame] was not vibrating, as I remember, am I right?

"Mr. Liverance: That is right.

"A. That is right" (R. 140).

When later questioned on cross examination concerning the function of the rubber blocks in question, Mr. Milewski made the further flat admission:

"A. There is a flexible coupling, and they do prevent the transmission of the vibration to the frame" (R. 175).

Thus, in addition to the Court's first-hand observation, both defendants' counsel, Mr. Liverance, and defendants' principal witness, Mr. Milewski, unequivocally and without reservation or subsequent retraction admitted that the frame of defendants' machine does not vibrate when the mold is vibrating, and Mr. Milewski later again admitted that the resilient rubber blocks interposed between the mold and frame in defendants' machines prevent the transmission of mold vibration to the frame (R. 175).

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The distinction relative to direction of ejection is likewise reflected in express limitations of other claims which are omitted from claim 6.

Thus claims 2 and 4 call for

> "a pallet positioned in said mold for vertical movement and providing a bottom therefor and a carrying platform for the material. * * * and means adapted for cooperation with the bottom of the pallet for pushing said pallet *upwardly* through said mold to eject the material carried thereby."

Claim 3 calls for

> "a pallet positioned in said mold for vertical movement and providing a bottom therefor, and a carrying platform for the material, * * * and means associated with the frame adapted for cooperation with the bottom of the pallet for pushing said pallet *upwardly* through said mold to eject the material carried thereby."

Likewise, claim 7 calls for

> "a pallet positioned in the mold and forming a bottom carrying platform for material introduced therein, * * * and means mounted on the frame for *elevating* the pallet relative to the mold to eject a formed mass of the material."

However, in claim 6, no such limiting language can be found. There is no mention of the position of the pallet and no mention of the direction of ejection, but instead the claim calls merely for "means for removing the formed mass of material from the mold, said last means including elements mounted upon the frame." Since defendants' stripper head unquestionably removes the formed mass of material from the mold and unquestionably includes

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elements mounted on the frame, the limitations of claim 6 relative to the ejecting mechanism are completely satisfied in defendants' machine, while the distinctions relied upon by the District Court relative to the ejecting mechanism from the subject matter of other claims which are not in suit.

Thus, the two principal distinctions relied upon by the District Court in support of its holding of non-infringement of claim 6 run squarely afoul the established law enunciated in the decisions of the Sixth Circuit and of this Court referred to above that a limitation in one claim cannot be read into another. The decision of the District Court is likewise in clear conflict with *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co., supra,* holding that infringement is made out if accused matter "falls clearly within the claim" as well as with *Smith v. Snow, supra,* holding that an inventor is not confined to the particular preferred embodiment disclosed in the specification "since the claims of the patent, not its specifications, measure the invention."

As we have mentioned heretofore, the Court of Appeals did not expressly concur in the District Court's holding of non-infringement of Scott, yet failed to correct the record holding which therefor remains as an erroneous precedent for the escape of practiced copyists who depart merely from the preferred embodiment without departing from the claimed subject matter.

POINT V

Mere file wrapper arguments cannot be allowed to enlarge, diminish or vary the language of a patent afterwards issued.

The second distinction relied upon by the court below in holding non-infringement of Claim 2 of the Gelbman method patent relates to the limitation of Claim 2 calling for "continuing the vibration of said mold and engaging *a yielding pressure head* on the material in the mold during said latter vibration period." The Gelbman patent discloses a **gravity actuated** pressure head which falls on the material in the mold and remains there while the mold vibrates in the finishing step. Defendants employ a **gravity actuated** pressure head which falls repeatedly (tamps) on the material during the finishing vibration period, as in the machine at Midland, or partially rests and partially tamps, as in the machine at Rogers City (R. 90, 91).

The dictionary definition of the term "pressure" is generic to either static or tamping pressure:

> "Pressure • • • The action of a force against some opposing force; a force in the nature of a thrust distributed over a surface." *Webster's International Dictionary.*

The Court of Customs and Patent Appeals has construed "tamping" and "pressure" as equivalent terms:

> "It seems to us that while appellant does not regard tamping the mix as external pressure applied thereto, it is in fact merely external pressure of a different sort." *In re Ruzicka,* 132 F. 2d 146, 149 (C. C. P. A.).

The term "yielding" in Claim 2 in fact merely distinguishes **gravity actuated** pressure from a **rigid** and **positive** pressure, such as exerted by the crank arm of the prior art Dahl patent (R. 217; Vol. II, R. 376). This fact is conceded by defendants as indicated in defendants' reply to Petition for Rehearing:

> "The distinction was over the Dahl unyielding squeeze pressure, differing therefrom in that the weight merely resting upon the concrete *was under no influence except that of gravity, and in that sense was yielding* as compared to the *forced mechanical and heavy unyielding* pressure of Dahl" (R. 382).

Thus, since both the Gelbman and defendants' pressure heads follow the vibrating material down into the mold under the influence of **gravity and gravity alone**, the expression "yielding pressure head" clearly involves no literal distinction which would exclude defendants' gravity actuated tamping operation.

All of the record evidence supports the complete equivalence of dynamic and static pressure in the final step. No testimony was introduced by defendants pointing to any difference in result because of defendants' pressure head falling more than once or repeatedly in the finishing operation. On the contrary, it appeared to be defendants' position during the trial that the result was the same regardless of which way the final compacting was done:

> "Q. (By Mr. Liverance): I will ask your opinion, from your experience, in connection with block manufacturing, and the machinery which you make to carry on block manufacturing, whether compacting by itself, by either tamping or by vibration, or by jolting, or by squeezing, if any of them does more than squeeze and push, and in a word compact the

particles of the concrete together? Does any one do anything more than that compacting?

"A. (By Mr. Milewski): No. That is the only purpose of it" (R. 165, 166).

The following very positive and most logical testimony of the expert witness, Brush, on this point not only stands completely uncontroverted but is in substantial agreement with that of defendants' witness Milewski above quoted:

> "In my opinion for that particular function of packing, in connection with continuing vibration, of packing the top of the molded block down to the desired height, whether the pressure is applied statically, while the vibration brings the top down, or whether it is applied dynamically as by tamping, the results are in every practical way the same (R. 302).
>
> • • •
>
> "I am very certain from observation and from reasoning that the dynamic application of pressure in connection with vibration and the static application of pressure in connection with like vibration for that particular job are mechanically one and the same thing" (R. 302).

The only ground asserted by defendants or adopted by the Court of Appeals for impressing a limitation on the term "yielding pressure head" which would exclude defendants' operation lies in a supposed file wrapper argument. Thus, as stated by the Court of Appeals:

> "But claim 2 describes a yielding pressure head on the material in the mold and the argument is that this is equivalent to the tamping used in the accused machines. *It is specified, however, that tamping or dynamic pressure results in an inferior block because the force engendered too greatly impacts the upper part of the material making too heavy*

> *a block.* So the term 'yielding pressure,' is clearly a limitation and the accused machines do not employ it" (R. 361, emphasis added).

The "specified" limitation emphasized above, assumed by the Court to distinguish between static pressure and tamping pressure in the final step of the Gelbman method, apparently refers to the following file wrapper argument:

> "The defects of the tamper machine and the press machine were well-known for many years. The main defect was that the concrete aggregate, that is, the grits, would be crushed by the hammering of the tampers, or by the pressure of the press machine. The crushing of the aggregate served to compact the blocks, producing heavy, objectionable building blocks." (Def. Ex. J, p. 104).

But this argument clearly was directed to defects of tamping machines **which employ no vibration** and was equally directed to **press** machines employing **static pressure without vibration.**

The Gelbman patent specification points out:

> "a preferred arrangement of the invention consists in simultaneously vibrating the mold while the pressure head is in operation so that the vibrations assist the pressure head in completing the packing of the block. *With this arrangement the weight of the pressure head and the amount of pressure necessary to be exerted by it is materially reduced.*" (p. 1, col. 2, l. 5-12).

Such arrangement will clearly reduce the pressure necessary whether it be in the form of dynamic tamping pressure or static pressure and will equally avoid the defects mentioned in the file wrapper argument and referred to by

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the Court in impressing an unwarranted limitation on the form of pressure required in the final step of the Gelbman method. Thus, the file wrapper argument relied upon by the Court as **distinguishing** tamping pressure from static pressure not only fails to distinguish between such forms of pressure but instead puts them in exactly the same category and refers only to defects attributable entirely and equally to machines employing either static or tamping pressure **without vibration**. There is no statement in the patent specification or the file wrapper or in any of the proceedings before either of the courts below distinguishing tamping pressure from static pressure as applicable to the final vibrating step of the Gelbman method. On the contrary, the uncontroverted record evidence establishes their complete equivalency.

Furthermore, even if it were assumed that an argument was actually advanced in the file wrapper distinguishing tamping or dynamic pressure from static pressure, such mere argument, under prior decisions of the Sixth Circuit, other Circuits, and of this Court could not be given estoppel effect in impressing a limitation on Claim 2 to avoid infringement when the claim would otherwise clearly cover defendants' operation.

The correct rule, as we understand it, is that expressed by the Second Circuit Court of Appeals in *Auto Pneumatic Action Co. v. Kindler & Collins*, 247 Fed. 323, 328:

> "The defendant, however, insists that the distinction which the applicant made of Brown's patent to the Examiner should estop him here. It is true that on May 4, 1904, the applicant did distinguish Brown's 'strikers,' which turn only axially from his own pivoted vertically swinging 'strikers'; but we attach no significance to his action, for no change in the claims accompanied it. For whatever

reason it may have arisen, it is of course true that a patent, unlike other formal instruments of the sort, although it is the final embodiment of the purposes of the parties, is subject in its interpretation to the prior negotiations of the parties in a single instance. Whether or not this is legally an anomaly, so far as we know there is no decision which goes further than to hold that, where the applicant has assented to changes in a claim upon a reference in the Patent Office, he may not, by subsequent construction, resort to the elements which he has thus abandoned. *We are far from being willing to establish a rule that arguments made in the Patent Office by the applicant to the examiner are to be taken as a measure of his patent. We read the claims as they are written, like the language of any other formal statement drawn up as the final memorial of the parties' intentions, and we decline to consider what was said arguendo during the passage of the case through the Patent Office, or any other of the preliminary negotiations which the patent itself was intended to subsume.*"

Such rule has been recognized by the court below in *Byers Machine Co. v. Keystone Driller Co.*, 44 F. 2d 283, 285 and conforms with the law on this subject as expressed by this Court:

> "We do not mean to be understood as asserting that any correspondence between the applicant for a patent and the Commissioner of Patents can be allowed to enlarge, diminish, or vary the language of a patent afterwards issued. Undoubtedly, a patent, like any other written instrument is to be interpreted by its own terms." *Goodyear Dental Vulcanite Co. v. Davis*, 102 U. S. 222.

The decision of this Court in *Schriber-Schroth v. Cleveland Trust Co.*, 311 U. S. 211 relied upon by the court below

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in support of its holding is not in point since that case involved the "cancellation of the only claims specifying flexible webs or their equivalents as a feature of the invention" together with an attempt to construe allowed claims as commensurate in scope wtih the abandoned subject matter of the cancelled claims, a case clearly involving technical estoppel as thoroughly established and recognized by all courts. Neither does *D'Arcy Spring Company v. Marshall Ventilated Mattress Company*, 259 F. 236 nor any of the other circuit court decisions relied upon (R. 361) support the court's holding in the present case since all of such other cases involved **express** limitations pertaining to the **inventive** step which **literally excluded** the accused subject matter.

POINT VI

That a formalistic, strict and technical approach should not predominate over substance in the consideration of patents in an infringement suit if duly issued patents are to continue to serve as an incentive to promote the progress of industry.

The decision and entire opinion of the court below is characterized by a resort to captious formalism in place of substance. Thus, first, an unprecedented disqualification of the **conceptual** as distinguished from **structural form** of inventive act, equally applicable to virtually all machine inventions, was made the basis for reversing the District Court's holding of validity and infringement of the Gelbman apparatus patent. Second, a technical supposed deficiency in the disclosure of vibrating apparatus, in fact amounting only to the omission of a precise physical dimension in describing the "slight," adjustable amplitude

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of vibration, was detected and distorted to strike down the Gelbman method patent; and, as coordinate grounds for vitiating such patent, technical distinctions (characterized by the District Court during trial as "infinitesimal" (R. 300); "So instantaneous that it doesn't amount to anything"; and, "does not make a particle of difference" (R. 308)) in the starting point of mold vibrations were seized upon together with a mere suppositious file wrapper argument as the basis for finding no infringement. Again, mere indefiniteness in the titles of patents combined with abuse of the varient meanings of the word "concentrating," covering diametrically opposite end results, were resorted to in rejecting plaintiffs' contention that the art of washing and separating ore is not analogous to the art of compacting concrete blocks, and proceeding therefrom to find the Scott patent anticipated and invalid.

The resort to such captious, meticulous and technical criteria for invalidating patents can leave but little incentive for inventors to expend the necessary time, money and effort to produce further revolutionary advances in the concrete block making industry or in any other industry where legitimate patent protection forms an inducement for development, but instead, if permitted to stand as authority, can only spread the dangerously growing dim view of this country's patents as enforceable contracts, which dim view has already gained international repute. See *"Patent Law: The British Trend," American Bar Association Journal,* March 1952, Vol. 38, p. 271.

Here we are dealing with vital contributions to a revolutionary advance in the concrete block making industry which served to double production and improve the quality of the block to an unforeseeable extent following thirty years of an inferior practice. The patent incentive clearly

formed the primary basis for inducing these essential developments which were not forthcoming from the manufacturers of block making equipment, notwithstanding their superior resources for development and favorable position for profitably exploiting any improvements. Instead, the advance came from individual inventors employing their own capital or the capital of those who could only realize a return from successful patents. Here the patent system obviously operated as intended by the framers of the Constitution and patent laws to provide the incentive to promote a marked industrial advance. Having reaped the unquestioned benefit of the Scott and Gelbman inventions—doubled production and a highly superior quality of block—which inventions are surely of a vastly higher order than the metal encasement of flashlight batteries recently sustained as a patentable invention in *Goodyear Tire Co. v. Ray-O-Vac Co.*, 321 U. S. 275, is the public now through the courts to renounce the patent contracts without more substantial grounds than resorted in the decision of the Court below?

We submit that the circumstances of this case, involving, as found by both courts below, a revolutionary advance in the concrete block manufacturing art, compellingly call for the application of a more liberal and substantive approach under the decisions of this court:

> "In administering the patent law the court first looks into the art to find what the real merit of the alleged discovery or invention is, and whether it has advanced the art substantially. If it has done so, then the court is liberal in its construction of the patent, to secure to the inventor the reward he deserves * * *. In the case before us, for the reasons we have already reviewed, we think that

Eibel made a very useful discovery which has substantially advanced the art. His was not a pioneer patent, creating a new art; but a patent which is only an improvement on an old machine may be very meritorious and entitled to liberal treatment. Indeed, when one notes the crude working of machines of famous pioneer inventions and discoveries, and compares them with the modern machines and processes exemplifying the principle of the pioneer discovery, one hesitates in the division of credit between the original inventor and the improvers; and certainly finds no reason to withhold from the really meritorious improver the application of the rule *'ut res magis valeat quam pereat,'* which has been sustained in so many cases in this court. *Winans v. Denmead,* 15 How. 338, 341, 14 L. ed. 720, 721; *Corning v. Burden,* 15 How. 265, 269, 14 L. ed. 689, 690; *Turrill v. Michigan S. & N. I. R. Co.,* 1 Wall. 491, 519, 17 L. ed. 668, 672; *Providence Rubber Co. v. Goodyear,* 9 Wall. 788, 795, 19 L. ed. 566, 568; *McClain v. Ortmayer,* 141 U. S. 419, 425, 35 L. ed. 800, 803, 12 Sup. Ct. Rep. 76." *Eibel Process Co. v. Minnesota & Ontario Paper Co.,* 261 U. S. 45, 63.

CONCLUSION

For reasons set forth in the foregoing petition and brief, it is respectfully submitted that certiorari should be granted to review the decision of the Sixth Circuit Court of Appeals below, and that such decision should be reversed and the cause remanded for a judgment of validity and infringement of the Scott patent 2,106,329, the Gelbman *et al.* machine patent 2,275,676 and the Gelbman *et al.* method patent 2,366,780.

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No. [redacted] 64

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

Elmore F. Amman, Louis Gherman, Eastern Manufacturing Co.,

Petitioners,

vs.

John A. Whitman, Melvin C. Wheeler, Howard W. Goodson,

Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR CERTIORARI

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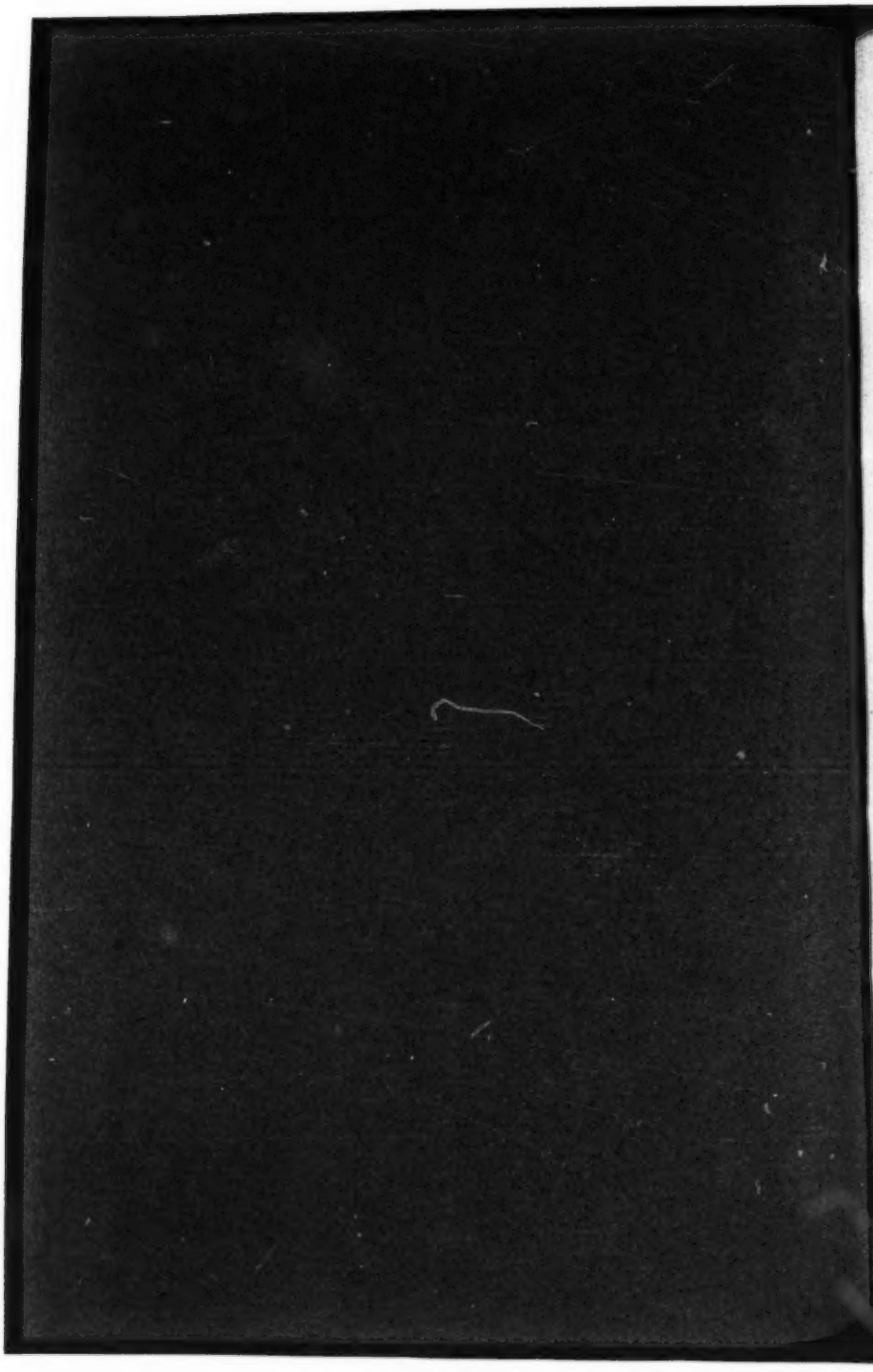

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No. 772

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

HAMLIN F. ANDRUS, LOUIS GELBMAN,
BESSER MANUFACTURING CO.,
Petitioners,

vs.

JOHN A. WHITMAN, MELVIN O. WENZEL,
HOWARD W. GOETSCH,
Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR CERTIORARI

INTRODUCTORY AND SUBJECT MATTER

The petition involves three patents, all of which have been held invalid by the Sixth Circuit Court of Appeals. One is the Gelbman apparatus or machine patent, No. 2,275,676. Another is the Gelbman method patent, No. 2,366,780. The one remaining is the Scott patent No. 2,106,329. These are located as to their positions in the Record in the first paragraph of page 3 of petitioners' Summary Statement of the Matter Involved.

None of these patents present any important question. All were held invalid under findings of fact which present nothing more than is presented in practically all litigation involving alleged infringement of a United States Letters Patent.

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GELBMAN MACHINE PATENT NO. 2,275,676

The Gelbman apparatus or machine patent, No. 2,275,-676, was first considered in the opinion of the Court of Appeals for the Sixth Circuit of the United States; and it was found that it had had a rough course through the Patent Office, after substantially five years prosecution, and finally allowed by the Board of Appeals in the Patent Office. Only the first claims numbered 1 to 4 inclusive were involved in the litigation. It was found that there was very pertinent prior art in the Dahl patent, No. 1,777,660, (R. p. 376, Vol. II), which had everything disclosed in the claimed structure of the Gelbman apparatus or machine patent, including all that was defined in each of the claims except that, while in Dahl the feed drawer moving over and dumping its contents in the mold rode at its lower edges on the mold, in the Gelbman machine the feed drawer was carried on tracks, which were described and claimed as acting to lift the lower edges of the feed drawer out of touching contact with the upper end of the mold, the asserted result being that the vibration of the mold was not transmitted to the feed drawer.

And in Shinn, No. 2,036,367, (R. p. 375, Vol. II), not before the Patent Office during prosecution of the Gelbman apparatus patent, a vibrating mold had moved over it, a feed drawer which dumped its contents into the mold and was carried on tracks which, like in Gelbman, were connected to a rigid frame; and, as shown in Fig. 5 of Shinn, the lower edges of the feed drawer were maintained above and out of touching contact with the upper side of the mold at all times during movement of the feed drawer over the mold. Therefore, upon these clear and undisputed facts, the court, at the top of the page (R. 360), said:

> "We hold the claims in suit invalid both for anticipation and lack of invention."

There is no important question of law involved. It is a normal, usual patent case decided by the court below finding out and determining the facts, and from said facts finding that the patent is invalid, as (1) anticipated, and (2) lacking invention. Under these circumstances it is submitted there is no important question of law or any safeguarding of the public against unwarranted monopoly to

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be raised. The petition has no substantial grounds on which to base it, in the matter of the Gelbman apparatus patent, No. 2,275,676.

GELBMAN METHOD PATENT NO. 2,366,780

This patent also follows the regular course of all normal patent litigation. The opinion of the Court of Appeals at R. 360, after stating that the District Judge was in considerable doubt as to the validity of the claims, but held them not infringed, then says:

> "We do not share his doubt."

In the next sentence it says the claims are *anticipated* in the prior art by patents already cited. Here is a fact finding of anticipation by patents already cited, a fact finding which this court, it is believed, should not even attempt to examine into. There is no question of law or major importance involved but really the simplest of fact determinations, clearly supported by the record evidence.

The court below also found that the claims were not infringed by the accused structure. This is another fact determination. The court applied no estoppel when it considered the file wrapper history. It merely used the file wrapper history to determine from the patentees, on their representations in prosecuting the application through the Patent Office, what the alleged invention was over prior art patents cited against it. The extremely voluminous history of this application in the Patent Office, and the fact that every feature of what was used was old and had been used before in compacting concrete into block or other forms was apparent to the court which, having no doubt whatsoever, held that there was an *anticipation* by the earlier patents; also no infringement.

Indeed, if the Supreme Court of the United States is to grant a petition for certiorari in patent cases under circumstances of those of the present case, it is submitted, that it should grant a petition for certiorari in every patent case.

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SCOTT PATENT NO. 2,106,329

The Scott patent was also held invalid by the Sixth Circuit Court of Appeals. Initially it was held invalid by the District Court, it is believed, both for aggregation and lack of invention. On rehearing the District Court withdrew the holding of invalidity for aggregation. Whether or not it was still held invalid for lack of invention is a debatable question and not important in the present proceeding. For whatever may be the facts with regard to that question, the Appellate Court after reciting these facts said (R. 365):

> "Our view is that the Court was right in the first place. The uniting of vibrating and ejecting means in a unitary structure was but an aggregation, each performing an old function in substantially the same way."

Here is a direct fact finding with respect to the Scott patent, which a petition for rehearing filed by the present petitioners did not touch upon when such petition was filed before the Appellate Court, the same as they did not touch upon the other direct findings earlier discussed in this brief respecting the Gelbman apparatus and method patents. The same observation with respect to the Supreme Court of the United States granting a petition for certiorari in a patent case, where there are no differing opinions of two Circuits, and nothing except an attack upon the factual findings of the Court of Appeals for the Sixth Circuit, apply.

After stating the direct holding that the two claims in suit in the Scott patent were invalid because defining aggregations the court then, as fact findings, found nothing new or disclosing inventive thought over the prior art as having been produced by Scott. It found, specifically, in the Taylor patent No. 899,441, the exact vibration control mounting of Scott which, in the present petition for certiorari, the petitioners attack on the ground that Taylor was to vibrate something different than what Scott was to vibrate.

However, both Taylor and Scott, got the same result by identical means. The result was to conserve the energy developed through rotating motors connected to a material

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holding receptacle by preventing any passage of vibration from the vibrating container to a carrying frame supporting it. This was for economy. A vibrating mold or other container which has such connection or contact with a fixed frame, by which vibrations in part carry into or are absorbed by the fixed frame, reduces the vibration transmitted by the mold and to its contents, damping vibration and making added expense which does not occur if such transmitted portion of the vibration energy is not thus absorbed and lost. In both Taylor and Scott, all of the vibrating energy transmitted to the container or mold is utilized. Taylor did it years before Scott. Though one may vibrate one material inside it and the other another material, that does not affect the desired result which both wanted, that of conserving power, utilizing all of it and not losing any of it; with resultant economy.

Taylor was cited, and claims in Scott, minus the last aggregated element in claims 1 and 6, finally rejected on Taylor. The acquiesecence in this rejection by not appealing forecloses the owner of the Scott patent from asking the Supreme Court of the United States, or any other court, to correct an alleged wrong which was not pursued as to its proper remedy when it could have been done in the Patent Office.

CONCLUSION

Everyone of the patents in suit were held invalid on usual, normal grounds of anticipation and lack of invention. There is no new and important question of law. This court does not need to look at this question from any standpoint of public safeguard. It is not like the case of *Great Atlantic & Pacific Tea Co. vs. Supermarket Equipment Corp.*, 340 U. S. 147, where obviously, an error in law had been made which, if not corrected, would result in the public being subjected to a truly monopolistic claim for the life of the patent.

It is further to be noted that outside of the Gelbman apparatus patent the District Court held the remaining patents, the Gelbman method patent and the Scott patent as not having been infringed. With respect to the Gelbman apparatus patent, the Appellate Court did not pass upon the question of infringement, but there is, and it was sub-

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mitted to both the District and Appellate Courts, a question of infringement; and it is believed that, clearly, there was no infringement irrespective of validity in all three patents. A certiorari grant would bring up all questions to this court involving not only the validity of these three patents but also the infringement questions involved therein.

As stated before, there being nothing extraordinary in this suit to call for the certiorari extraordinary remedy, and as normally cases involving validity and infringement of patents are finally ended when a Circuit Court of Appeals passes thereon, it is submitted that the petition should be denied. For as mentioned before, if there are grounds for granting the petition in this case, there is no patent case which does not have quite as adequate grounds, and some far more.

Respectfully submitted,

FRANK E. LIVERANCE, JR.,
Attorney for Respondents.

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JUN 14 1952
CHARLES ELMORE CROP
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IN THE

Supreme Court of the United States

No. [redacted] 64

HAMLIN F. ANDRUS, LOUIS GELBMAN and BESSER MANUFACTURING COMPANY,
Petitioners,
vs.
JOHN A. WHITMAN, MELVIN O. WENZEL and HOWARD W. GOETSCH,
Respondents

REPLY BRIEF FOR PETITIONERS

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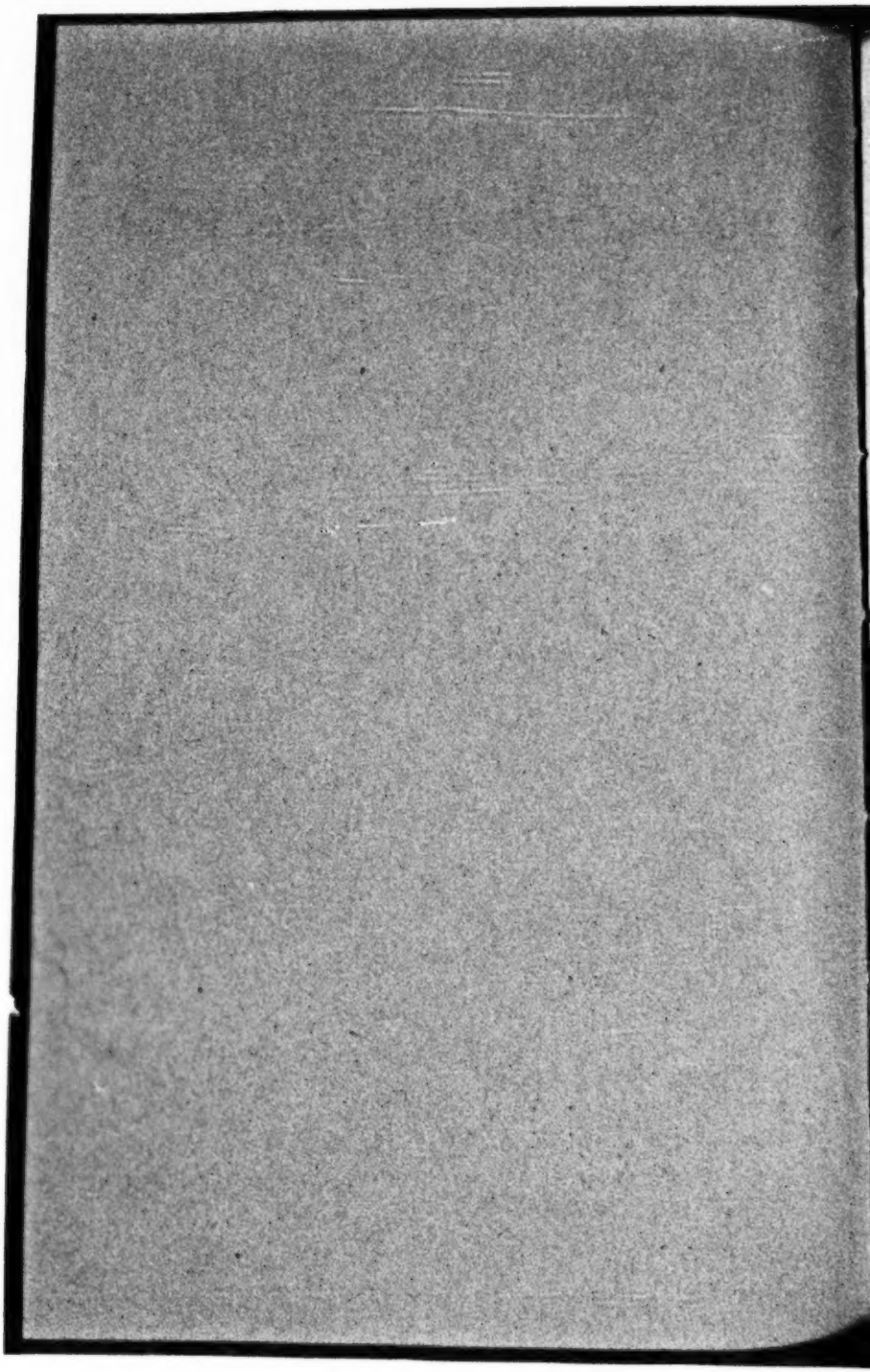

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IN THE

Supreme Court of the United States

No. 772

HAMLIN F. ANDRUS, LOUIS GELBMAN and BESSER MANUFACTURING COMPANY,
Petitioners,
vs.
JOHN A. WHITMAN, MELVIN O. WENZEL and HOWARD W. GOETSCH,
Respondents

REPLY BRIEF FOR PETITIONERS

Respondents' opposition to the present petition for writ of certiorari to review the decision of the Sixth Circuit Court of Appeals initiating holdings of invalidity of the Gelbman apparatus and method patents and the Scott patent is summarized in the following statement found on page one of respondents' brief:

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> "None of these patents present any important question. All were held invalid under findings of fact which present nothing more than is presented in practically all litigation involving alleged infringement of a United States Letters Patent."

Respondents totally disregard the questions of law concerning legal standards of patentable invention, sufficiency of disclosure, claim construction and analogous art involved in the grounds squarely relied upon in the Court of Appeals' opinion upon which review is now sought.

As to the importance of these questions, petitioners have pointed out in their main brief wherein the Court of Appeals has radically departed from established law concerning these matters in a manner affecting vital areas of our established patent system. For example, as discussed at pages 37 to 44 of petitioners' main brief, the Court of Appeals' unprecedented disqualification of inventive **concepts**, as distinguished from **structure**, to satisfy the requirement for invention in supporting patentability of machines clearly would stand as authority for virtually eliminating the entire statutory class of mechanical inventions.

Respondents have in no way contested petitioners' construction of this unprecedented ruling, nor that such ruling was made in error, nor that if permitted to prevail it would threaten the entire statutory class of mechanical inventions. Neither do respondents contest, attempt to meet, or in any way deny, the vital importance of the other legal issues raised by the petition. Instead, respondents attempt to sidestep these issues by suggesting suppositious but more conventional alternative grounds, and mislabeling them as mere fact findings, in the apparent hope that this Court will not examine too carefully into the unprecedented legal

grounds squarely relied upon by the Court of Appeals, but will instead take the "easy way out" by accepting respondents' erroneous explanation of the case as involving mere routine fact finding.

GELBMAN MACHINE PATENT No. 2,275,676

Thus, respondents' argument in connection with the Gelbman machine patent proceeds upon a distortion of the record and the Court of Appeals' opinion, in an attempt to create the impression of a holding of complete anticipation. In truth, neither the District Court nor the Court of Appeals found anticipation for the main Gelbman apparatus feature of eliminating vibration transmitting contact between the mold and the feed drawer, nor for eliminating the objectionable packing of concrete material in the main supply hopper resulting from mold to feed drawer vibration transmitting contact. Respondents' statement on page 2 of their opposition brief that such feature was found to be anticipated by Shinn is directly contrary to the findings of both the District Court and the Court of Appeals. The District Court after listening to considerable testimony from both sides regarding the disclosure of the Shinn patent concluded in its opinion:

> "The drawings indicate that the hopper feed box would vibrate with the mold.
>
> "Furthermore, the Shinn patent does not entirely remove the probability of the undesirable transmission of consolidating mold vibration to the material in the main supply hopper through an intermediate feed drawer. [In Shinn] The hopper is the feed box" (R. 331).

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Far from disagreeing with the District Court's finding as to lack of anticipation of this feature by Shinn, the Court of Appeals' opinion expressly concurs therein. Thus, after discussing the disclosure in Shinn of certain elements of the Gelbman apparatus, the Court of Appeals proceeds in its opinion (R. 358) to a discussion of what is **not** anticipated by Shinn or any other prior art reference:

> "That which is more urgently urged as new in Gelbman is the means provided for holding the feed drawer from touching the mold so as to prevent the transmission of vibrations from the mold to the feed drawer."

Furthermore, there was no holding by the Court of Appeals that this feature lacked inventive thought. The only basis for dismissing this important feature of the Gelbman apparatus in holding the patent invalid was that any inventive aspects therein resided in **concept** rather than embodying **structure**, and that inventive concept cannot satisfy the requirement for invention to support patentability of a machine (R. 359). It is this square ruling of law, that invention in concept, as distinguished from structure, is not sufficient to satisfy the requirement for invention to support the validity of a machine claim, that forms the ultimate and final basis for the Court of Appeals' overruling of the District Court's holding of validity of patent No. 2,275,676. It is solely upon this important legal ruling, which stands as a threat to the validity of every machine patent, that petitioners seek review regarding the Gelbman apparatus patent.

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GELBMAN METHOD PATENT No. 2,366,780

Respondents' argument as to the Gelbman method patent is based upon a further clear distortion of the Court of Appeals' opinion in a second attempt to create the impression of a holding of complete anticipation. Contrary to respondents' contention, the Court of Appeals made no holding that the **Gelbman method** was anticipated by prior art. The statement by the Court of Appeals regarding anticipation, seized upon on page 3 of respondents' brief, refers solely to the **first step** alone of the Gelbman method and not to the method as a whole.

> "Insofar as the claims describe a method for making building blocks consisting of *moving a feed drawer across a vibrating mold until it is superimposed on the mold to fill and pack it,* the claims are anticipated by the prior art in patents already cited." (R. 360—Emphasis added.)

The Court of Appeals refers to novelty in the second step in a later section of its opinion:

> "What is said to be new in the method is the continued vibration of the mold during pressure after the feed drawer is removed" (R. 362).

and there was clearly no holding that the method as a whole is anticipated by the prior art. The Court of Appeals expressly based its holding of invalidity **primarily** on:

> "failure of the method patent to fully disclose the alleged inventive concept so that the method may be practiced by the public when the patentee's monopoly has expired" (R. 363).

Such "principal ground," was never pleaded, argued or in any way raised as an issue before either of the courts below, and, judging from respondents' stated position, is not even now urged by respondents to be a correct holding. In truth, such holding involves a clear error of law as to the standards of sufficiency of disclosure by requiring, in effect, the complete disclosure of **quantitative** details as to power **apparatus**, already known to the art for the purpose employed, even where the patent is for a **method** and the apparatus suggested is wholely collateral to the novel and inventive method subject matter. Such holding, particularly in the light of the exhaustive qualitative disclosure of the apparatus in question, clearly involves a drastic departure from standards of adequate disclosure established by this Court in such cases as

Tilghman v. Proctor, 102 U. S. 707;
Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U. S. 45, 65, 66;
Webster Loom Co. v. Higgens, et al., 105 U. S. 580, 586;
Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403, 437; and
Expanded Metal Co. v. Bradford, 214 U. S. 366, 379, 380.

The decision of the Sixth Circuit Court of Appeals, if permitted to stand, would open to attack innumerable patents disclosing previously known power apparatus in qualitative terms heretofore uniformly believed to be, and accepted as, entirely adequate.

In connection with holdings of noninfringement of the Gelbman method patent, there was never any disputed fact issue concerning defendants' method of operation and the

sole issues before both courts below, upon which review is now sought, are legal issues of claim construction, viz., the failure of the courts below to give effect to distinctions between different claims and their resort to suppositious mere file wrapper arguments (which in fact had no relevance), to impose an unnatural construction on Claim 2. Thus, the errors upon which review is sought involve no **fact** determination as alleged by respondents. Instead, petitioners submit that the Court of Appeals clearly has departed from thoroughly established **law** concerning important principles of claim construction thereby opening the door to new evasion of patent rights by practiced copyists.

SCOTT PATENT No. 2,106,329

Petitioners seek review of the Court of Appeals' holding, based primarily on a comparison of the broad terminology in the "Titles" of the Taylor Patent 899,441 (Vol. II, p. 377) and the Scott patent, that the device for washing and separating ore of the Taylor patent is found in an art analogous to that of the Scott device which is directed to an improved machine for a more effective compacting of concrete blocks whereby superior blocks of greater strength and uniformity are produced. It is petitioners' contention that diametrically opposite end results are involved; that one seeking better means for **compacting** a concrete block would not naturally look to the art of washing and **separating** ore; and that the Taylor patent is accordingly found in a nonanalogous art in the sense of the patent law.

Respondents (Br. p. 5) seize upon a mere ancillary advantage, the economy of conserving energy, and apparently contend it is sufficient to establish analogy of the otherwise diverse arts. But such contention glosses over the diametri-

cally opposite end purposes to which the respective devices are directed and ignores the basic significance of the term "art" in the legal concept of "analogous art" as used in the patent law. One seeking improved means for compacting a damp concrete mix to obtain concrete building blocks of greater strength and uniformity would not be led by any logical process to search the **art of conserving energy.** This is not an art at all in any true sense but merely a desired result common to all arts employing power equipment. Such mere ancillary concepts, or statements of corollary advantages, cannot constitute "arts" in the sense of the patent law which instead clearly comprehends specific industrial or commercial activities identified by the end products involved. Nor can they properly be seized upon to submerge, or render analogous, the diametrically opposite end results of washing and separating ore to obtain as final products one batch of finer particles of one material and a separate batch of coarser particles of another material, as distinguished from that of compacting concrete to obtain but a single end product, a compact block comprising uniformly distributed diverse materials having both relatively fine and coarse particles completely intermingled.

The following final statement regarding Scott, made in the last paragraph of page 5 of respondents' brief, attempts to spell out a theory of estoppel binding petitioners to a supposed acquiescence in the pertinence of Taylor as an anticipating reference:

> "Taylor was cited, and claims in Scott, minus the last aggregated element in claims 1 and 6, finally rejected on Taylor. The acquiescence in this rejection by not appealing forecloses the owner of the Scott patent from asking the Supreme Court of the United States, or any other court, to correct an alleged wrong which was not pursued as to its proper

remedy when it could have bee been done in the Patent office."

The above-quoted statement from m respondents' brief is erroneous both in its premise and iid in its conclusion. The Examiner's rejection of subcombinatination claims on Taylor to which respondents have referencence, to-wit:

> "Claims 25, 29 and 30 are furthurther rejected on Taylor of record alone. To substitutitute a mold for member 11 would not involve inventiention." (Paper No. 6, Scott File Wrapper History, ry, Defendants' Exhibit F, page 29.)

was in the next Office Action expresressly withdrawn by the Examiner as follows:

> "The rejection of Claims 21, 25, 25, 29 and 30 on Taylor alone is hereby withdrawn." " (Paper No. 8, Defendants' Exhibit F, p. 34.)

Prior to the cancellation of any of of such claims by Scott's patent solicitor, Taylor was entirelyely abandoned as a reference (Paper No. 25, Defendants' s' Exhibit F, p. 61), and Claim 1 (Original Claim 19) directected to the complete combination, including ejecting means, w, was allowed by the Examiner before any of the subcombibination claims omitting the ejecting means were canceled. d. Under these circumstances there is no applicable doctctrine of estoppel which prevents petitioners from relying g either on the lack of anology between the art of ore w washing and separating and that of compacting concrete blococks, or the resulting lack of pertinence of Taylor as a refererence, or the novelty and invention in the Scott subcombinatation without the ejecting means. Even though claims to thhe subcombination alone were canceled, inventive aspects (of such subject matter

clearly may support the patentability of the complete combination of the allowed claims as long as no attempt is made to construe the allowed claims as having equal scope with the canceled subcombination claims.

W. S. Godwin Co. v. International Steel Tie Co., 2 F (2d) 198 (C. C. A. 6);
General Electric Co. v. Save Sales Co., et al., 82 F (2d) 100 (C. C. A. 6); and
Egry Register Co. v. Standard Register Co., 267 F. 186 (C. C. A. 6).

Since respondents' machines employ the ejecting means of the complete combination, and no attempt has been made to construe such claims as if this element were omitted and thus equal in scope to the canceled claims, there is no basis for estoppel; nor would there be even if the subcombination claims had been finally rejected and canceled on Taylor, as erroneously urged by respondents.

With Taylor properly eliminated, as belonging to a non-analogous art, the Court of Appeals' holding of aggregation predicated on old elements each performing an old function in substantially the same old way obviously cannot stand, and as pointed out in our main brief (pp. 65, 66) such holding is in direct conflict with a controlling decision of the same Sixth Circuit Court of Appeals in *Egry Register Co. v. Standard Register Co.*, 267 Fed. 186, involving a completely parallel fact situation.

CONCLUSION

Respondents' assumption that there is an important public interest in applying correct standards of invention and other doctrines of patent law only when they operate to strike down an improper patent, and that there is no equal public interest in correcting improper standards where the result is to sustain a proper patent, is believed to proceed upon a fundamental misconception. We take it that the public interest in applying a correct standard of invention in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, did not lie to any great extent, if at all, in establishing free use of the particular device there in question but rather resided in establishing a correct standard of invention for future guidance in future cases so as to free industry generally of unwarranted patent claims. We also believe it clear that there is an equal, if not even greater, public interest to be served by establishing and maintaining correct standards for upholding and enforcing patents in proper cases thereby to preserve the patent incentive as intended by the Constitution and Statutes and prevent destructive erosion and deterioration of the patent system by improper judicial construction. To hold otherwise would be to hold that the public is importantly interested only in grounds for voiding patents and that the promulgation of proper standards for enforcing such public contracts is of no great public concern, a conclusion manifestly incompatible with the basic Constitutional premise for authorizing Congress to establish a patent system.

Since the filing of this petition, this Court has handed down a decision in *Besser Manufacturing Co., et al. v. United States* (decided May 26, 1952) which has the effect

rom proceeding under
of finally precluding petitioners ingers in any other cir-
the patents in question against info seek a different deci-
cuit so that it becomes impossible by obtain conventional
sion in another circuit and therrdingly, under the deci-
access to this Court's review. Acc *Ace Patents Corp.*, 315
sions of the *Exhibit Supply Co. v. v. Outboard M. & Mfg.*
U. S. 126 and *Muncie Gear Works* the importance of the
Co,. 315 U. S. 759, and in view o decision in question and
legal issues squarely raised by the his case most properly
this petition, it is submitted that s Court.
and urgently warrants review by th

Respectfully submitte

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